Hovsepian v. Apple, Inc. Doc. 208

HENNIGAN, BENNETT & DORMAN LLP
RODERICK G. DORMAN (SBN 96908)
ALAN P. BLOCK (SBN 143783)
KEVIN SHENKMAN (SBN 223315)
865 South Figueroa Street, Suite 2900
Los Angeles, California 90017
Phone: (213) 694-1200
Fax: (213) 694-1234
dormanr@hbdlawyers.com
blocka@hbdlawyers.com
shenkman@hbdlawyers.com

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	CASE NO. 05 CV 01114 JW MDL No. 1665 **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S COMBINED REPLY IN SUPPORT OF ITS LEGAL MEMORANDUM RE THE DEFINITIONS OF CLAIM TERMS FROM THE '863 AND '720 PATENTS AND TERMS FROM THE '992 PATENT THAT THE COURT HAS ALREADY CONSTRUED** **DATE:** September 7-8, 2006 **TIME:** 10:00 a.m. **CTRM:** Hon. James Ware

Dockets.Justia.com

TABLE OF CONTENTS

(Page)

I. INTRODUCTION 1

II. CLAIM 14 OF THE '863 PATENT 1

1. "Transmitting Compressed, Digitized Data Representing a Complete Copy of at Least One Item of Audio/Video Information at a Non-Real Time Rate From a Central Processing Location" and "Wherein the Transmitting Step Comprises" ('863 Patent, Claim 14; '720 Patent, Claim 8) 1

a) The Term "Representing" is Definite 1

b) The Court Should Not Limit the "Complete Copy" to All of the Information for the Item Having Information 3

c) The Term "Central Processing Location" is Definite 4

d) Acacia Agrees with the Round 3 Defendants that the "Compressed, Digitized Data" is the "Compressed and Sequenced Addressable Data Blocks" Formed in the Formatting Steps. 8

2. "Inputting an Item Having Information Into the Transmission System" ('863 Patent, Claim 14 and 17) 9

3. "Assigning a Unique Identification Code to the Item Having Information" ('863 Patent, Claims 14 and 17) 9

4. "Formatting the Item Having Information as a Sequence of Addressable Data Blocks" ('863 Patent, Claims 14 and 17) 11

5. "Receiving the Transmitted Compressed, Digitized Data Representing a Complete Copy of the at Least One Item of Audio/Video Information, at a Local Distribution System, Remote From the Central Processing Location" ('863 Patent, Claims 14 and 17; '720 Patent, Claims 8 and 11) 11

6. "Storing the Received Compressed Digitized Data Representing the Complete Copy of the at Least One Item at the Local Distribution System" ('863 Patent, Claims 14 and 17) 15

7. "In Response to the Stored Compressed, Digitized Data, Transmitting a Representation of the at Least One Item at a Real-Time Rate" ('863 Patent, Claim 14, '720 Patent, Claim 8) 15

TABLE OF CONTENTS (cont'd)

(Page)

a) The Term "Representation" in Claim 14 of the '863 Patent is Definite. 15

b) The Phrase "In Response to the Stored Compressed, Digitized Data" Does not Mean that the Data "Triggers" the Transmission 16

8. "At Least One of a Plurality of Subscriber Receiving Stations Coupled to the Local Distribution System" ('863 Patent, Claim 14) 17

9. "Decompressing the Compressed, Digitized Data Representing the at Least One Item of Audio/Video Information After the Transmission Step Wherein the Decompressing Step is Performed in the Local Distribution System to Produce the Representation of the at Least One Item For Transmission To The At Least One Subscriber Station" ('863 Patent, Claim 14) 20

III. CLAIM 15 OF THE '863 PATENT 22

10. "Wherein the Inputting Step Comprises Inputting the Item Having Information as Blocks of Digital Data" ('863 Patent, Claims 15, 18) 22

IV. CLAIM 16 OF THE '863 PATENT 21

11. "Wherein the Inputting Step Comprises Inputting the Item Having Information as an Analog Signal and Converting the Analog Signal to Blocks of Digital Data" ('863 Patent, Claims 16 and 19) 21

V. CLAIM 17 OF THE '863 PATENT 23

12. "Formatting Items of Audio/Video Information as Compressed Digitized Data at a Central Processing Location" and "Wherein the Formatting Step Comprises" ('863 Patent, Claim 17) 23

13. "Transmitting Compressed, Digitized Data Representing a Complete Copy of at Least One Item of Audio/Video Information at a Non-Real Time Rate From a Central Processing Location" ('863 Patent, Claim 17) 24

14. "Using the Stored Compressed, Digitized Data to Transmit a Representation of the at Least One Item to at a Plurality of

TABLE OF CONTENTS (cont'd)

(Page)

Subscriber Receiving Stations Coupled to the Local Distribution System" ('863 Patent, Claim 17) 23

a) The Term "Using" is Definite 23

b) The Phrase "to at a Plurality of Subscriber Receiving Stations" 26

15. Whether Each Step of Claims 14 and 17 of the 863 Patent and Claims 8 and 11 of the '720 Patent Begin and Occur Only After a Prior Step or Steps Have Been Completed. 26

VI. CLAIMS 4, 7, 8, AND 11 OF THE '720 PATENT.. 27

16. "Subscriber Selectable Receiving Stations" ('720 Patent, Claims 4, 8, and 11).. 27

17. "Means, Responsive to the Stored, Compressed Digitized Data, for Transmitting a Representation of the at Least One Item of Audio/Video Information at a Real-Time Rate to at Least One of the Plurality of Subscriber Selectable Receiving Stations" ('720 Patent, Claim 4).. 27

18. "Means for Inputting Items of Audio/Video Information" ('720 Patent, Claim 7) 30

19. "Conversion Means for Placing Each Item of Audio Video Information Into a Predetermined Format as Formatted Data" ('720 Patent, Claim 7) 32

20. Transmitter Means for Sending Compressed Formatted Data for the at Least One Item of Audio/Video Information at the Non-Real Time Rate to the Reception System" ('720 Patent, Claim 7)... 34

21. ". . . Transmitting, Using a Transmitting Means, a Representation of the at Least One Item at a Real-Time Rate to at Least One of a Plurality of Subscriber Selectable Receiving Stations" ('720 Patent, Claim 8) 35

VII. CLAIM TERMS FROM THE '992 PATENT THAT THE COURT HAS ALREADY CONSTRUED.. 35

22. "Transmission System" ('992 Patent, Claims 19 and 41; '275 Patent, Claims 2 and 5; '863 Patent, Claims 14 and 17).................. 35

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

TABLE OF CONTENTS (cont'd)

(Page)

a) The Court Did Not Find that the Patentees Disavowed the Ordinary Meaning of "Transmission System," as the Round 3 Defendants Contend 36

b) The Disclosure in the Specification of Only a Single Embodiment Does Not Limit the Claimed Invention to the Features Described in the Disclosed Embodiment 37

c) There is no Expression in the Specification or Prosecution History that the Patentees Intended to Limit "Transmission System" to the Embodiment in Figures 2a and 2b 41

d) The Term "Transmission System" is not Indefinite............. 46

e) Acacia Requests Reconsideration of the Court's Construction of "Transmission System" to Remove the "Reception System" from the Court's Construction 46

23. "Reception System" ('275 Patent, Claims 2 and 5) 47

24. "Storing Items Having Information in a Source Material Library" ('992 Patent, Claim 41) 48

a) The Court Construed the Term "Source Material Library" in Markman I to Mean "a Collection of Existing Materials"... 48

b) The Round 3 Defendants Misquote the Specification.......... 49

c) Nothing in the Specification or the Prosecution History Teaches that the Source Material Library is a "Jukebox-Like" Device 51

d) There is Written Description for the Method Step of "Storing Items Having Information in a Source Material Library"... 53

e) Acacia Seeks Reconsideration of the Court's Construction of "Storing Items in a Source Material Library" So as to Conform the Meaning of "Storing" Throughout the Claims to Mean "Adding or Maintaining"... 55

TABLE OF CONTENTS (cont'd)

(Page)

25. "Items Containing (or Having) Information" ('992 Patent, Claims 19 and 41; '275 Patent, Claims 2 and 5; '863 Patent, Claims 14 and 17) 57

a) The Court Should Not Limit the Phrase "Items Having Information to "Physical Objects" 57

b) The Patent Specification is Enabled 59

26. "Remote Locations" ('992 Patent, Claim 41) 61

27. "Retrieving the Information in the Items from the Source Material Library" ('992 Patent, Claim 41) 62

a) The '992 Patent is Enabled 64

28. "Assigning a Unique Identification Code to the Retrieved Information" ('992 Patent, Claim 41) 64

29. "Placing the Formatted Data into a Sequence of Addressable Data Blocks" ('992 Patent, Claim 41) 65

a) The Court Has Construed the Phrase "Sequence of Addressable Data Blocks" 65

b) The Phrase "Sequence of Addressable Data Blocks" Does not Have any Ordinary Meaning; the Patentees Acted as Their Own Lexicographers 66

c) The Term "Addressable" in the Phrase "Sequence of Addressable Data Blocks" Does Not Refer to Addressability in the Compressed Data Library 67

d) A "Data Block" is a Frame of Video or a Sample of Audio 71

e) The Court Cannot *Infer* any Meaning to the Phrase "Sequence of Addressable Data Blocks" from the Examiner's Silence in the later-filed '863 Patent Prosecution History 73

f) "Ordered Data Blocks" Means "Sequence of Addressable Data Blocks" 73

TABLE OF CONTENTS (cont'd)

(Page)

g) The Round 3 Defendants' Proposed Construction of the Phrase "Sequence of Addressable Data Blocks" is Improper 74

30. "Storing, as a File, the Compressed, Formatted, and Sequenced Data With the Assigned Unique Identification Code" ('992 Patent, Claim 41) 74

VIII. CONCLUSION 76

TABLE OF AUTHORITIES

(Page)

Cases

Altiris, Inc. v. Symantec Corp.
318 F.3d 1363 (Fed. Cir. 2003) 40

Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.
340 F.3d 1298 (Fed. Cir. 2000) 51

Bancorp Servs., LLC v. Hartford Life Insurance Group Co.
359 F.3d 1367 (Fed. Cir. 1996) 20, 24, 31

Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.
262 F.3d 1258 (Fed. Cir. 2001) 67

BJ Servs., Inc., v. Haliburton Energy Servs.
338 F.3d 1368 (Fed. Cir. 2003) 59

British Telecomms. PLC v. Prodigy Communis. Corp.
217 F.Supp. 2d 399 (S.D.N.Y. 2002) 6, 7

Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.
334 F.3d 1294, (Fed. Cir. 2003) 40, 45

CCS Fitness v. Brunswick Corp.
288 F.3d 1359 (Fed. Cir. 2002) 38, 40, 41, 42

Conoco, Inc. v. Energy & Envtl. Int'l, L.C.,
__ F.3d ___, 2006 U.S. App. LEXIS 21036, at *16 (Fed. Cir. August 17, 2006) 38

Cordis Corp. v. Medtronic AVE, Inc.
339 F.3d 1352 (Fed. Cir. 2003) 53

DeMarini Sports, Inc. v. Worth, Inc.
239 F.3d 1314 (Fed. Cir. 2001) 73

Electro Medical Sys., S.A. v. Cooper Life Sciences
34 F.3d 1048 (Fed. Cir. 1994) 42, 62

Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.
279 F.3d 1022 (Fed. Cir. 2002) 9, 10, 22, 65

Ex Parte Henry A. Erlich and Linda J. Nyari
1986 Pat. App. LEXIS 13; 3 U.S.P.Q. 2d (BNA) 1011 23

Exxon Research and Eng’g Co. v. United States
265 F.3d 1371 (Fed. Cir. 2001) 26, 31

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

TABLE OF AUTHORITIES (cont'd)

(Page)

Fuji Photo Film Co. v. United States Int'l Trade Comm'n
386 F.3d 1095 (Fed. Cir. 2004) 40

Gart v. Logitech, Inc.
254 F.3d 1334 (Fed. Cir. 2001) 51, 73

Gemstar –TV Guide Int'l, Inc. v. United States Int'l Trade Comm'n
383 F.3d 1352 (Fed. Cir. 2004) 40

Genentech, Inc. v. The Wellcome Foundation Ltd.
29 F.3d 1555 (Fed. Cir. 1994) 71

Gillette Co. v. Energizer Holdings, Inc.
405 F.3d 1367 (Fed. Cir. 2005) 40, 44

Golight, Inc. v. Wal-Mart Stores, Inc.
355 F.3d 1327 (Fed. Cir. 2004) 40, 66

Harold Schoenhaus v. Genesco, Inc.
440 F.3d 1354 (Fed. Cir. 2006) 40

Hoganas AB v. Dresser Indus.
9 F.3d 948 (Fed. Cir. 1993) 29

In re Application of Koller
613 F.2d 819 (C.C.P.A. 1980) 55

In re Gardner
480 F.2d 879 (C.C.P.A. 1973) 54, 55

Inpro II Licensing, S.A.R.L. v. T-Mobile USA, Inc.
450 F.3d 1350 (Fed. Cir. 2006) 45

Irdeto Access, Inc. v. EchoStar Satellite Corp.
383 F.3d 1295 (Fed. Cir. 2004) 43

JVW Enters., Inc. v. Interact Accessories, Inc.
424 F.3d 1324 (Fed. Cir. 2005) 66

Kinzenbaw v. Case LLC
2006 U.S. App. LEXIS 10656 (Fed. Cir. 2006) 28

Leibel-Flarsheim Co. v. Medrad, Inc.
358 F.3d at 898 (Fed. Cir. 2004) 22, 39, 40, 45

Lockheed Martin Corp. v. Space Systems/Loral, Inc.,
324 F.3d 1308 (Fed. Cir. 2003) 29

TABLE OF AUTHORITIES (cont'd)

(Page)

Medrad, Inc. v. MRI Devices Corp.
401 F.3d 1313 (Fed. Cir. 2005) 17, 57

Merck & Co. v. Teva Pharms. USA, Inc.
347 F.3d 1367 (Fed. Cir. 2003) 17

Micro Chemical, Inc. v. Great Plains Chemical Co.,
194 F.3d 1250 (Fed. Cir. 1999) .... passim

Miles Lab. v. Shandon, Inc.
997 F.2d 870 (Fed. Cir. 1993) 46

Modine Mfg. Co. v. United States, Int'l Trade Comm'n
75 F.3d 1545 (Fed. Cir. 1996) 45

Network Commerce, Inc. v. Microsoft Corp.,
422 F.3d 1353 (Fed. Cir. 2005) 19

Northern Telecom, Inc. v. Datapoint Corp.
908 F.2d 931 (Fed. Cir. 1990) 61

Novartis Pharms. Corp. v. Abbott Labs.
375 F.3d 1328 (Fed. Cir. 2004) 67

Novo Indus., L.P. v. Micro Molds Corp.
350 F.3d 1348 (Fed. Cir. 2003) 25

Personalized Media Communis., LLC v. United States Int'l Trade Comm'n
161 F.3d 696 (Fed. Cir. 1998) 64

Phillips v. AWH Corp.
415 F.3d 1303 (Fed. Cir. 2005) .... passim

Pitney Bowes, Inc. v. Hewlett-Packard Co.
182 F.3d 1298 (Fed. Cir. 1999) 41, 71

Prima Tek II, LLC v. Polypap
318 F.3d 1143 (Fed. Cir. 2003) 5, 9, 51

Renishaw, PLC v. Marposs Societa' per Azioni
158 F.3d 1243 (Fed. Cir. 1998) 57

Resonate, Inc. v. Alteon Websystems, Inc.
338 F.3d 1360 (Fed. Cir. 2003) .... passim

Rexnord Corp. v. Laitram Corp.,
274 F.3d 1336, 60 USPQ2d 1851 (Fed. Cir. 2001) 42, 43, 45

TABLE OF AUTHORITIES (cont'd)

(Page)

S3, Inc. v. nVidia Corp.
259 F.3d 1364 (Fed. Cir. 2001) 31

Seal-Flex, Inc. v. Athletic Track & Court Constr.
172 F.3rd 836 (Fed. Cir. 1999) 28

Smithkline Beechham Corp. v. Apotex Corp.
403 F.3d 1331 (Fed. Cir. 2005) 46

SRI Int'l. v. Matsushita Elec. Corp. of America
775 F.2d 1107 (Fed. Cir. 1985) 5, 22, 42, 44

Standard Oil Co. v. American Cyanamid Co.
774 F.2d 448 (Fed. Cir. 1985) 17

Teleflex, Inc. v. Ficosa N. Am. Corp.
299 F.3d 1313 (Fed. Cir. 2002) .... passim

TI Group Auto. Sys. v. VDO N. A., LLC
375 F.3d 1126 (Fed. Cir. 2004) 51

Toro Co. v. White Consol. Indus.
199 F.3d 1295 (Fed.Cir. 1999) 45

Transclean Corp. v. Bridgewood Servs., Inc.,
290 F.3d 1364 (Fed. Cir. 2002) 28

Union Oil Co. v. Atlantic Richfield Co.
208 F.3d 989 (Fed. Cir. 2000) 54

Wang Labs., Inc. v. America Online, Inc.
197 F.3d 1377 (Fed. Cir. 1999) 45

Statutes

35 U.S.C. § 112 .... 41, 46, 65

35 U.S.C. § 112(6) 31, 33

35 U.S.C. § 254 26

35 U.S.C. § 255 26

TABLE OF AUTHORITIES (cont'd)

(Page)

Periodicals

Television Engineering Handbook
(1992) at 9.9 and Figure 9-2 (1982) 7

I. INTRODUCTION

Acacia hereby responds to the defendants' legal briefs regarding the claim terms from the '863 patent, the '720 patent, and the reconsideration terms from the '992 patent.

Although various of the defendant groups contend that certain of the claim terms from the '863 and '720 patents are indefinite, there is no term from any patent for which all of the defendant groups contend is indefinite. Thus, looking at the totality of the defendants' submissions alone, there is an available construction for each claim term in these patents and no claim term is "insolubly ambiguous" or indefinite.

The Round 3 defendants seek reconsideration of many of the claim terms from claim 41 of the '992 patent which the Court construed in its Markman I Order. In each case, the Round 3 defendants invite the Court to commit legal error by importing all of the limitations from the specification, and some not even stated in the specification, into the claims. The Federal Circuit has repeatedly rejected the same reasoning offered by the Round 3 defendants here. With two minor exceptions, described herein, the Court should let stand its prior constructions for these terms.

II. CLAIM 14 OF THE '863 PATENT

1. "Transmitting Compressed, Digitized Data Representing a Complete Copy of at Least One Item of Audio/Video Information at a Non-Real Time Rate From a Central Processing Location" and "Wherein the Transmitting Step Comprises" ('863 Patent, Claim 14; '720 Patent, Claim 8)

a) The Term "Representing" is Definite

Acacia contends that the term "representing" in this phrase of claim 14 of the '863 patent means a "reproduction," i.e., the compressed, digitized data that is transmitted is a "reproduction of" the at least one item of audio/video information; it is not the at least one item of audio/video information.[1]

The Round 3 defendants do not offer a separate construction for the term "representing" and do not contend that this term is indefinite in this phrase or in any other phrase in this claim or in any other claim in which it is used.

[1] Acacia also contends that the term "representation" as used elsewhere in claim 14 and in claim 17 of the '863 patent and as used in claims 4, 6, 8, and 11 of the '720 patent means "reproduction."

Round 2 satellite defendants start their analysis by consulting three dictionary definitions for "represent" and "representation." They then make the improper assumption that all of the possible definitions for these terms could apply to the term "representing" as used in the claims and therefore conclude that there is no boundary as to the meaning of "representing." (Round 2 Satellite defendants' Opposition, at 18:1-4). This approach to claim construction, which ignores the context of the claims and the specification, has been rejected by the Federal Circuit. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) ("The problem is that if the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition, the error will systematically cause the construction of the claim to be unduly expansive. The risk of systematic overbreadth is greatly reduced if the court instead focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history, rather than starting with a broad definition and whittling it down.")

The Round 2 satellite defendants also contend that there is no disclosure in the specification of an embodiment wherein data "representing" a complete copy of an item is transmitted from the central processing location to a local distribution system or where a "representation" of the item is transmitted from the local distribution system to a user's location. (Round 2 satellite defendants' Opposition, at 19:12-16). This is not the case. Throughout the specification, the patentees describe the process wherein uncompressed "items" are compressed to create compressed data, which may be stored as a file in a compressed data library. (*See*, e.g., '863 patent, 5:63 – 10:36). The file comprising the compressed data "represents" the item, i.e., it is not the item in its original, uncompressed format; it is a *reproduction* of the uncompressed item in a compressed format. This process is also illustrated in the examples provided in the specification of a cable television system, which is an example of a transmission from a central processing location to a local distribution system and then to a user's location.[2] (*See, e.g.*, '863 patent, 4:13 – 5:29; Figures 1d-1g).

The examples from the specification referred to by the Round 2 satellite defendants are not

[2] The specification also describes how, before transmission, the compressed data is converted using the transmission data converter 119 and this converted data is transmitted. ('863 patent, 15:13 – 28; See also, Figure 2b).

applicable to the claims-at-issue. In the claims, compressed, digitized data is formed from an item having information. This compressed, digitized data is not the item; it is compressed, digitized data which is a "representation" (i.e., a reproduction) of the information. This is shown in the Round 2 satellite defendants' example from claim 17 of the '863 patent. (Round 2 satellite defendants' Opposition, at 18:5 – 19:10. So-called "data set (1)" is the item of audio/video information, which in claim 17 is not in the correct format for transmission from the central processing location to the local distribution system. Thus, the information undergoes the formatting steps, wherein it becomes so-called "data set (2)" (distinct from "data set (1)"), i.e., the compressed, digitized data representing the complete copy of at least one item of audio/video information.

In spite of the clear language of the claim that it is the compressed, digitized data that represents a complete copy of the item, the Round 2 satellite defendants argue that "[i]t is unclear whether this representation is itself a complete copy, a symbol of a complete copy, or an encoded or decoded version of a complete copy." (Round 2 satellite defendants' Opposition, at 18:26 – 19:10). The language of the claim itself makes clear that it is the compressed, digitized data that is transmitted, not a symbol or the uncompressed item itself.

Acacia will address the Round 2 satellite defendants' contentions regarding "representation" in Section No. 7, *infra*.

b) The Court Should Not Limit the "Complete Copy" to All of the Information for the Item Having Information

The Round 3 defendants contend that the phrase "a complete copy of at least one item of audio/video information" means "a copy of all of the audio/visual information contained on the at least one physical object."[3] Acacia contends that there is no such limitation in the claims, nor should one be added through claim construction.

The Round 3 defendants state that Acacia does not dispute that the "item" in the phrase "representing a complete copy of at least one item" is the "item containing information." (Round 3 defendants' Opposition, at 58:24 – 59:2). Acacia does dispute this. Neither the "at least one item of

[3] Acacia objects to construing the item as a "physical object." Acacia shall address the Round 3 defendants' contentions re "physical object" in Section No. 25, *infra*.

audio/video information" nor the "item having information" relies on the other for its antecedent basis. Claim 14 uses the phrases: "at least one item of audio/video information" and "inputting an item having information." The two phrases are not the same.

Further, there is no limitation in the claims or in the specification that the "item having information" that is input into the transmission system has only *one* item of audio/video information; it could have one or more than one "item of audio/video information," i.e., it may have one movie, two movies, or one movie with multiple scenes, wherein each scene is itself an "item of audio/video information." Nothing in the claims or in the patent specification requires that an "item" comprise any specific number of frames, any specific length or time, or be a complete movie, rather than, for example, a scene from a movie.

The Round 3 defendants further contend that if the "at least one item of audio/video information" were not the "item having information," then the "complete copy" limitation would be indefinite. The Round 3 defendants ignore the fact that the "complete copy" limitation appears elsewhere in the claim and has meaning even if the "at least one item of audio/video information" was not the entire "item having information." This is because the claim also states that the complete copy that is transmitted is also received and stored in the local distribution system. Thus, "complete copy" has meaning to ensure that all of what is transmitted from the central processing location is received and stored at the local distribution system.

Additionally, claim 14 states that what is being sent is "at least a portion of the file [having the compressed, formatted, and sequenced data blocks]" and "at least one item of audio/video information." Thus, "at least one item of audio/video information" may not even be the entire file.

The Round 3 defendants also contend that "one frame" could be an item. This is impossible, because one frame of video is a still image and the claim limits the "at least one item of audio/video information" to *video* information. Video information requires motion and thereby requires that there be more than one frame.

c) The Term "Central Processing Location" is Definite

Acacia contends that the term "central processing location" means "the principal site or location where processing occurs."

The Round 3 defendants contend that the "central processing location" is the location at which all of the processing is exclusively performed, i.e., there can be one *and only one* processing location for two or more remote units (i.e., local distribution systems). As support, the Round 3 defendants refer to something called "centralized processing" and distinguish it from "decentralized processing," both of which refer to computer processing facilities (i.e., the location where computer processing functions are performed). (Round 3 defendants' Opposition, at 54:12-22). But, the '863 patent does not claim or relate to centralized processing or to computer processing. Rather, the '863 patent claims use the term "central processing location" to refer to the location where the transmission system is located and thus the location where the formatting of audio/video information (i.e., the processing) occurs.

The Round 3 defendants contend that their construction is "consistent" with the specification, which depicts a transmission system as the "hub" and the reception systems as the "spokes" in a hub-and-spoke architecture, referring only to Figures 1b and 1c as support. The Round 3 defendants are attempting to rewrite these claims so as to import Figures 1b and 1c into the claims as limitations. This, of course, would be improper. *See, Prima Tek II, LLC v. Polypap,* 318 F.3d 1143, 1148-49 (Fed. Cir. 2003) ("Similarly, the mere fact that the patent drawings depict a particular embodiment of the patent does not operate to limit the claims to that specific configuration.") The Round 3 defendants do not attempt to distinguish or even address any of the cases cited by Acacia in its opening brief which hold that the Court cannot import limitations from the specification into the claims. Instead, without any legal support whatsoever, the Round 3 defendants merely state that the claims should be limited to these embodiments of the specification.

The Round 3 defendants further contend that "there is no disclosure of a reception system which communicates with more than one transmission system, and there is no disclosure of a reception system that does not receive information directly from a transmission system." (Round 3 defendants' Opposition, at 56:12-14). As a matter of law, the '863 patent is not limited to the embodiments depicted in the specification – in other words, Acacia's claims may be broader than the embodiments depicted in the specification. *See, SRI Int'l. v. Matsushita Elec. Corp. of America,* 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*) ("If everything in the specification were required to read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment.")[4]

The '863 patent specification does not state that a local distribution system must only communicate with one transmission system or that a local distribution system must only receive information from only one transmission system. Indeed, the '863 patent inherently discloses to persons of ordinary skill in the art that a local distribution system can communicate with more than one transmission system and that a local distribution system can receive information from more than one transmission system. This is because the specification discloses that the invention may be embodied in a cable television system. ('863 patent, 4:13-50; Figures 1d-1f). It was well-known to persons of ordinary skill in the art in 1991 that, in a cable television system, a local distribution system can communicate with more than one transmission system and that a local distribution system can receive information from more than one transmission system. This was clearly demonstrated in the *Television Engineering Handbook*, (1992) at 9.9 and Figure 9-2 (1982), which shows a cable head receiving programming from a number of different sources. (Exhibit 12 to Block Suppl. Decl.)

The Round 3 defendants do not address the fact that their proposed construction would also be contrary to the open-ended transitional phrase "comprising," used in the claims. As Acacia described in its opening brief, this transitional phrase means that the claims do not preclude a local distribution system which can communicate with more than one transmission system and a local distribution system which can receive information from more than one transmission system.

The Round 3 defendants further rely on *British Telecomms. PLC v. Prodigy Communis. Corp., 217 F.Supp. 2d 399, 410 (S.D.N.Y. 2002)*. In *British Telecommunications*, the court

[4] Although the Round 2 defendants contend that the term "central processing location" is indefinite, they also contend that, if definite, the "central processing location" should be limited to "a single location at which all of the audio and video information to be received by the local distribution system is formatted and compressed, digitized data and transmitted." (Round 2 satellite defendants' Opposition, at 7:6-23). The Round 2 satellite defendants make essentially the same arguments as do the Round 3 defendants, and thus Acacia will not separately address the Round 2 satellite defendants' contentions here.

construed the term "central computer." This is distinguished from the present case where the term at issue is a transmission system at a "central processing location." The court in *British Telecomms.* specifically stated that its ruling was limited to "central computers," and did not apply to "systems:"

> The cornerstone of this argument is BT's assertion that a central computer is not limited to a single computer as a matter of law. To support its position, BT quotes a statement I made in *TM Patents, L.P. v. Int'l Business Machines Corp.*, 72 F. Supp. 2d 370, 380 (S.D.N.Y. 1999) while construing the claim term "a multi-unit memory system:"
>
> > Of course, the fact that the patent claims 'a' system does not mean that IBM or some other party would escape liability for infringement by constructing two or three or even more such multi-unit memory systems and somehow linking them together or causing them to operate together.
>
> *Id*. at 380. The flaw in BT's cornerstone argument is obvious. Not only was I not construing the Sargent patent in *TM*, I was not even construing the term "central computer" when I wrote those words. I was construing the word "system." n3 A system is not the same thing as a computer, and I never said that it was. A computer, according to the dictionary, is "a device that receives, processes and presents data," *Dictionary of Scientific and Technical Terms* 342 (Sybil P. Parker ed., McGraw Hill 3d ed. 1984), while a system is "a combination of several pieces of equipment integrated to perform a specific function" or "a group of related structures." *Id.* at 1600. Thus, the word "system" fairly implies multiple devices connected together. The Sargent patent does indeed cover a system, one that includes a central computer as one of its elements. BT conflates the system with the computer. But I made it clear in the Markman opinion (as the Sargent patent claims make clear) that the computer is but one component of the system.

British Telecomms., 217 F.Supp.2d at 410-411.

The Round 3 defendants further contend that, although the claim only requires that the central processing location send information to one local distribution system, it is "inherent" in the term "central processing location" itself that the central processing location serve "two or more remote locations" in a hub-and-spoke fashion. (Round 3 defendants' Opposition, at 55, n. 28). The Round 3 defendants provide no support for this position, and therefore the Court should not adopt their construction.

The Round 3 defendants and the Round 2 satellite defendants further contend that, if the Court adopts Acacia's construction, then the term "central processing location" will be indefinite, because a potential infringer would have no way of ascertaining which "'processing' has to be principally performed at the 'central processing location' or what percentage of that processing has to be done at a location for it to be the 'principal' processing location." (*See*, Round 3 defendants' Opposition, at 58:14-18). But, the claims are clear that all of the formatting steps of the claims must occur at the central processing location and that the transmission system is located at the central processing location. This is part of Acacia and the Round 3 defendants' proposed constructions. The "central processing location" refers to the location at which the formatting steps that are listed in the claim are performed. Other, non-primary processing (not recited in the claims) may occur at locations other than the central processing location. This is relevant in the claims, because the specification describes the transmission system as being capable of being spread over a plurality of facilities ('863 patent, 5:58-60) and describes elements of the transmission system as being at different locations, for example: multiple source material libraries located at different geographic locations ('863 patent, 6:19-29); the item database located in different locations ('863 patent, 11:26-29); and multiple remote order processing and item databases at different locations ('863 patent, 11:47-51).

The Round 2 satellite defendants further contend that the term "central" has to refer to a "center," by relying the dictionary definition referenced by Acacia. Although the Round 2 satellite defendants purport to quote the dictionary definition, they exclude the portion of the definition referred to by Acacia: "basic, essential, principal, dominant: not peripheral or incidental." It is not surprising that the Round 2 Satellite defendants reach a ridiculous result, since they start with an unrelated dictionary definition.

d) Acacia Agrees with the Round 3 Defendants that the "Compressed, Digitized Data" is the "Compressed and Sequenced Addressable Data Blocks" Formed in the Formatting Steps.

The Round 3 defendants point out that Acacia did not address the Round 3 defendants' proposed construction for "compressed, digitized data" as "the compressed and sequenced addressable data blocks." Acacia agrees with the Round 3 defendants, except that, in claim 14, the compressed and sequenced data blocks," came from the "at least a portion of the file."

2. "Inputting an Item Having Information Into the Transmission System" ('863 Patent, Claim 14 and 17)

Acacia contends that the "inputting" phrase simply means "the act of providing an item having information to the transmission system."

The Round 2 defendants contend in the Joint Claim Chart that this phrase is indefinite, however, they do not address this phrase in their Opposition.

The Round 3 defendants' proposed construction for this phrase is similar to Acacia's, except that the Round 3 defendants add the limitation that the "item having information" is a "physical object," which Acacia has addressed in Section 25.a., *infra*, and add the limitation that the item is input to the "source material library." The Round 3 defendants ignore the case law, cited in Acacia's brief, which holds that, to interpret the "inputting" phrase in a method claim to include structure (the source material library) that is not stated in the claim, would improperly import a limitation from the specification. *See*, *Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1032 (Fed. Cir. 2002).

The Round 3 defendants do not cite any cases which hold that, under these circumstances, a structural limitation from the specification can be imported into a method claim, where no structure is recited. Instead, they merely point to Figure 2 of the patent as proof that the item must only be input to the source material library. *See*, *Prima Tek*, 318 F.3d at 1148-49 ("Similarly, the mere fact that the patent drawings depict a particular embodiment of the patent does not operate to limit the claims to that specific configuration.") It would be improper, as a matter of law, to import the "source material library" limitation into this claim phrase. *See, e.g., Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002); *Resonate, Inc. v. Alteon Websystems, Inc.*, 338 F.3d 1360, 1365 (Fed. Cir. 2003) ("Courts may not rewrite claim language based on what has been omitted from the claim, and the district court's attempt to do so here was legal error.")

3. "Assigning a Unique Identification Code to the Item Having Information" ('863 Patent, Claims 14 and 17)

Acacia contends that the "assigning" phrase means that a unique identification code (one-of-a-kind identifier) is assigned to the item having information and that the unique identification code identifies the information through the rest of the formatting steps so that, in claim 14, the compressed data is stored in a file with the unique identification code. There is no provision in claim 17 for storing the compressed data with the unique identification code.

Both groups of defendants dispute the portion of Acacia's construction which states that the unique identification code identifies the information through the rest of the formatting steps. Acacia added this language for consistency with the Court's prior construction in Markman I of the similar phrase in the claims of the '992 patent. However, in view of the defendants' arguments, Acacia is willing to revise its construction as follows:

> The phrase "assigning a unique identification code to the item having information" means "assigning a one-of-a-kind identifier to the item having information."

The Round 3 defendants contend that the construction of the "assigning" phrase, which describes an act, but does not describe the structure used to perform the act, must be re-written to include the limitation that the act of assigning a unique identification code may only be performed using an "identification encoder." Again, the Round 3 defendants rely solely on a embodiment that is in the specification, but is *not* in the claim.[5] Defendants do not distinguish or even address the cases cited by Acacia in which the Federal Circuit has held that importing limitations from the specification would be legal error and do not cite any cases which would permit the court to import such structural limitations into a method claim. The Round 3 defendants are thus inviting the Court to commit legal error if it were to adopt their construction. *See, e.g., Teleflex, Inc.*, 299 F.3d at 1327; *Epcon Gas*, 279 F.3d at 1032; *Resonate*, 338 F.3d at 1365 ("Courts may not rewrite claim language based on what has been omitted from the claim, and the district court's attempt to do so here was legal error.")

The Round 3 defendants further contend that the identification encoder, which the Round 3 defendants seek to add to this claim step, must not only assign a unique identification code, it must also ascertain whether the information in the item is already in analog or digital format, and, if it is not, convert the information into an analog or digital format. None of these acts are included in the claim and it would be legal error to include these limitations in the claims. Further, as discussed in more detail in Section No. 27, nothing in the specification even requires or even states or suggests that these acts be performed by the identification encoder.

---

[5] In its Markman II Order, the Court held that adding the method steps of claim 41 recite acts, not structures, and therefore the phrase "assigning a unique identification code" did not require an identification encoder. (Markman II, at 16:10-17).

4. "Formatting the Item Having Information as a Sequence of Addressable Data Blocks" ('863 Patent, Claims 14 and 17)

Acacia contends that the "formatting" step should be interpreted to mean the "act of converting the format of the information from the item and placing the formatted information into time encoded data blocks."

The Round 2 satellite defendants only dispute the fact that Acacia's construction interprets the "sequence of addressable data blocks," consistent with the Court's construction, to mean time encoded data blocks. Acacia addressed the Round 2 satellite defendants' contentions regarding the meaning of "sequence of addressable data blocks" during the prior Markman briefing and hearing on June 14, 2006.

The Round 3 defendants contend that the "item" is limited to a "physical object"[6] and that it is "operated on" to convert the information stored on the physical object into a sequence of addressable data blocks. The Round 3 defendants are incorrect to construe the item having information as a "physical object" and are incorrect to state that the "physical object is operated on."

5. "Receiving the Transmitted Compressed, Digitized Data Representing a Complete Copy of the at Least One Item of Audio/Video Information, at a Local Distribution System, Remote From the Central Processing Location" ('863 Patent, Claims 14 and 17; '720 Patent, Claims 8 and 11)

After further reviewing its construction for "local distribution system" and in view of the defendants' arguments regarding "local distribution system," Acacia hereby revises its proposed construction for "local distribution system" to: (1) provide a construction for "local distribution system" which is the same for claims 14 and 17 of the '863 patent and claims 8 and 11 of the '720 patent, but takes into account the differences in the context in which the "local distribution system" appears in these claims, and (2) to include language relating to the fact that the "local distribution system" only transmits information within a "specific geographic region:"

---

[6] Acacia disputes construing the item as a "physical object."

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

> The term “local distribution system” in claims 14 and 17 of the ‘863 patent and claims 8 and 11 of the ‘720 patent means “an assembly of elements, hardware and software that function together to distribute, i.e., transmit, information within a specific geographic region.”
>
> In the context of claim 14, the “local distribution system” receives transmitted data, stores the data, decompresses the data, and transmits the data to at least one subscriber receiving station.
>
> In the context of claim 17, the “local distribution system” receives transmitted data, stores the data, and transmits the data to a plurality of subscriber receiving stations.
>
> In the context of claims 8 and 11, the “local distribution system” receives transmitted data, stores the data, and transmits the data to at least one of a plurality of subscriber selectable receiving stations

Neither the Round 3 defendants nor the Round 2 satellite defendants believe that the term “local distribution system” is indefinite. The Round 3 defendants agree with Acacia’s original construction. (Round 3 defendants’ Opposition, at 70:1-8). Only the Round 2 cable defendants contend that the term “local distribution system” is indefinite.

The Round 2 satellite defendants contend that the construction for “local distribution system” must include the limitation that the “local distribution system” not only transmit to a “local geographic region,” but it must also be located in the “local geographic region.” The limitation that the “local distribution system” itself be *located* in the geographic region is not contained in the claim or in the meaning of local distribution system, and therefore the Court should not include this limitation in the construction.

The Round 2 satellite defendants further contend that that the “local distribution system” is analogous to a cable head end and therefore it serves discrete geographic areas. Acacia agrees that the “local distribution system” must only serve discrete geographic areas. The Round 2 satellite defendants, however, also contend that the discrete geographic area must be limited to “the size of a city or a town.” (Round 2 satellite defendants’ Opposition, at 12:7-10).

Acacia disagrees with a construction which limits the “local” geographic area to “the size of a city of town.” Instead, the geographic area need only be a specific geographic area. In the context of these patents and these claims, which relate not only to cable television systems, but also to broadcast television and satellite television systems,[7] the term "local" would have been understood by persons of ordinary skill in the art to mean not only the geographic area served by a cable head end, but also to mean the geographic area wherein a broadcast signal (whether broadcast television or satellite) can be received over-the-air. For example, a resident of Los Angeles is capable of receiving her "local" broadcast television stations over the air. She cannot receive a broadcast of a San Francisco television station over the air, and thus she does not live within the specific geographic area within which the San Francisco television stations broadcast. Thus, the Los Angeles resident's "local" television stations are the Los Angeles broadcast stations, not the San Francisco broadcast stations.

The Round 2 cable defendants contend that the term "local distribution system" is indefinite. These defendants contend that the term "local distribution system" cannot mean the same thing as the terms "cable head end," "intermediate storage device," or "reception system" – similar terms which are also used in the patent claims. These terms do not have the same meaning as "local distribution system:"

- "Local distribution system" does not mean the same thing as "cable head end," because a "cable head end" is limited to cable transmissions, whereas a "local distribution system" is not limited to cable transmissions. A "local distribution system" encompass operation with broadcast transmission, such as television transmissions or satellite transmissions, or computer networks, which are communication channels that are described in the specification.
- "Local distribution system" does not mean the same thing as "intermediate storage device," because an "intermediate storage device" is limited to a storage device; it performs no distribution functions and is not a system which is embodied in an assembly of elements, software and hardware, as is the "local distribution system."
- "Local distribution system" does not mean the same thing as "reception system,"

[7] Claims 14 and 17 do not specify the communication channel, and therefore, consistent with the specification, these claims could cover cable television as well as broadcast and satellite television. (*See*, *e.g.*, '863 patent, 4:51-61).

> because a "reception system" is interpreted as "an assembly of elements, hardware and software, that function together to receive information. "Local distribution system" is interpreted as "an assembly of elements, hardware and software, that function together to distribute, i.e., transmit, information."

The Round 2 cable defendants further contend that the term "local" is indefinite, because "local" could have a variety of meanings. As discussed above, "local" would have been understood by persons of ordinary skill in the art to refer to the geographic coverage of a cable head end system or the over-the-air signal of a television or a satellite broadcast. Each of these geographic areas are limited and therefore define what is meant by "local." Taking defendants' examples, if a cable head end serves Paducah, Kentucky, plus some defined area outside the Paducah city limits, then this cable head end would not be a "local distribution system," because it serves more subscribers than merely those living within the Paducah city limits. This cable head end would, however, be included in Acacia's construction. Similarly, over-the-air broadcasts from a television transmitter may be received by residents of Paducah *and* residents living outside the Paducah city limits. According to Acacia's construction, a resident who lives outside the Paducah city limits, but nevertheless can receive the over-the-air signal of Paducah's television station, is within the "local" geographic area for that local distribution system (i.e., television station). A resident of Los Angeles, for example, would be unable to receive the over-the-air signal from the Paducah television station, and therefore Los Angeles would not be part of Paducah's local distribution system's geographic area.

The Round 2 cable defendants further contend that Acacia's construction for "local distribution system" is largely functional. Acacia's past and present definition specifically states that the "local distribution system" is "an assembly of elements, hardware and software, . . ." This is hardly a "functional" definition. It is also similar to the Court's prior construction for "system" in other similar contexts, such as "transmission system" and "reception system."

The Round 2 defendants further contend that prosecution history supports their construction, because of statements regarding *Tindell*. In *Tindell*, a Central Data Facility 10 communicates with a Receiving Unit 16 by way of a Telephone Network 12. See *Tindell* Fig. 1. There is no local distribution system, with storage etc. as specified in the various claims, interposed between the

Receiving Unit and the Central Data Facility of *Tindell*. Thus, the statements regarding *Tindell* do not evidence a disavowal that the term "local" in "local distribution system" is limited to a city or a town.

6. "Storing the Received Compressed Digitized Data Representing the Complete Copy of the at Least One Item at the Local Distribution System" ('863 Patent, Claims 14 and 17)

The Round 3 defendants have revised their construction of this phrase to remove the limitation that the data is in the "same storage device." Thus, there no longer appears to be any dispute between the parties with respect to this phrase.

7. "In Response to the Stored Compressed, Digitized Data, Transmitting a Representation of the at Least One Item at a Real-Time Rate" ('863 Patent, Claim 14, '720 Patent, Claim 8)

a) The Term "Representation" in Claim 14 of the '863 Patent is Definite.

Acacia contends that the term "representation" in claim 14 of the '863 patent refers to a reproduction in a decompressed format of the compressed digitized data representing at least one item of audio/video information. This is evident from claim 14 itself, which states the act of "decompressing the compressed, digitized data representing the at least one item of audio/video information after the transmission step . . . to produce the representation of the at least one item for transmission to the at least one subscriber station."

The Round 3 defendants do not offer a separate construction for the term "representation." In the Joint Claim Chart, the Round 3 defendants do not contend that the term "representation" is indefinite, however, in their Opposition, when discussing the "decompressing" step, they state that the term "representation" is indefinite, but then state in their brief that the description of "decompressing" in claim 14 "may save the term." (Round 3 defendants' Opposition, at 74:21 – 75:11). Acacia will therefore presume that the Round 3 defendants do not contend that the term "representation" is indefinite.

The Round 2 satellite defendants contend that the term "representation" is indefinite. (*See,* Round 2 satellite defendants' Opposition, at 20:19 – 21:5). Specifically, the Round 2 satellite defendants contend that claim 14 does not "define the content of the representation. Is a representation a complete digitalization of the entire work, or just an abridgement, symbol or rendition?" (Round 2 satellite defendants' Opposition, at 21:2-3). Claim 14 does define the content of the representation – it is the complete copy of the at least one item of audio/video information. This complete copy is formatted in the formatting steps to create the compressed, digitized data which represents the complete copy of the at least one item of the audio/video information. This compressed, digitized data (all of it, not a symbol, not an abridgement, and not a rendition) is later decompressed to create the representation of the at least one item of audio/video information that is transmitted to the at least one subscriber receiving station.

b) The Phrase "In Response to the Stored Compressed, Digitized Data" Does not Mean that the Data "Triggers" the Transmission

Acacia contends that the phrase "in response to the stored compressed, digitized data" means that the representation of the at least one item of audio/video information is not transmitted until after all of the compressed data has been received at the local distribution system and stored there.

Both groups of defendants contend that this phrase means that the data itself "triggers" the local distribution system to transmit the information. The Round 2 satellite defendants do not refer to the specification for support for data "triggering" the transmission.

The Round 3 defendants refer to the "buffer"[8] example from the specification, which Acacia relies upon. In this portion of the specification, the patentees state that "the reception systems 200 [of Figures 1a-1g] may either buffer the requested data for later viewing . . ." ('863 patent, 4:66-67). The Round 3 defendants contend that the only way for this embodiment to work would be for the user to include, with their request, a time at which playback should occur, and therefore there is information in the data which tells the local distribution system when to play the data to the user. (Round 3 defendants' Opposition, at 72:8-12). The specification is not limited in the manner described by the Round 3 defendants. There is no requirement described in the specification that the user *must* include a playback time with their request or that, if a playback time is required, there is information in the data which "triggers" the transmission. Instead, the specification states that selecting the playback time in the request is merely *optional*. ('863 patent, 5:8-12). Indeed, when referring to the "buffer" embodiment, the patent teaches that the data can be stored for playback "at a time of their choosing." ('863 patent, 5:19-29). Viewing at a time of the user's choosing is different than including a playback time in the initial request, because the specification states that the user can view the *requested* material *after* it has been stored "*at a time of their choosing*:"

---

[8] Here, the word "buffer" is used in the specification to describe storing the data before it is transmitted.

> A reception system with such storage is capable of storing several requested items for future playback. The user could then view and/or record a copy of the decompressed requested material in real time, or compressed in non-real time, at a time of their choosing.

('863 patent, 5:22-27).

To construe the phrase "in response to" to mean "triggers" would be inconsistent with the specification and therefore the Court would commit legal error if were to limit this phrase to "triggers." *See, Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) ("We cannot look at the ordinary meaning of the term … in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history."); *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985) ("the descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims."); *Merck & Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003) ("A fundamental rule of claim construction is that terms in a patent document are construed with the meaning with which they are presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part.")

8. "At Least One of a Plurality of Subscriber Receiving Stations Coupled to the Local Distribution System" ('863 Patent, Claim 14)

Acacia contends that the "subscriber receiving station" is "a subscriber's assembly of elements, hardware and software, capable of functioning together to receive a representation of an item of audio/video information."

The Round 3 defendants contend that the "subscriber receiving station" is a subscriber device on which playback occurs, i.e., it is a playback device. The Round 3 defendants contend that Acacia's construction, which would include systems, such as those in Figure 6 having capabilities such as decompression and storage, is improper, because there is no disclosure in the specification of one "reception system" transmitting to another "reception system." (Round 3 defendants' Opposition, at 73:15-21 and 74:1-3).

This is not the case; the specification does describe an embodiment in which one "Figure 6" system transmits to another "Figure 6" system. The '863 patent describes an embodiment of the invention referred to as a "non-direct connection reception system," which is depicted in Figure 1f. In the non-direct connection reception system embodiment, the reception system 200' includes a storage device. The local distribution system of claims 14 and 17 performs the act of storing, and therefore the reception system 200' of the non-direct connection reception system is analogous to the local distribution system of claims 14 and 17. The specification states that, in the non-direct connection reception system embodiments, the user could view and/or record a copy of either the decompressed or the *compressed* material:

> A reception system with such storage is capable of storing several requested items for future playback. The user could then view and/or record a copy of the decompressed requested material in real time, or compressed in non-real time, at a time of their choosing.

('863 patent, 5:22-27).

Thus, if a user is to be capable of playing back or recording *compressed* information that is transmitted from an intermediate storage device in a reception system, the user would have to have another "Figure 6" system (with its decompressor, output converter and storage) so that the compressed information received by the user could be decompressed and output in the proper analog format for playback. Thus, the specification does in fact disclose an embodiment of the invention wherein a Figure 6 system is disclosed at both an intermediate position and at the user's location.

With respect to the meaning of "subscriber receiving station," in claims 14 and 17 of the '863 patent, the construction of this term has to be the same in each claim. Claim 14 discloses that only decompressed information is transmitted to the subscriber receiving station, but claim 17 does not limit the information transmitted to the subscriber receiving station to decompressed information and therefore compressed information can be transmitted in claim 17. Thus, the construction of "subscriber receiving station" proposed by Acacia is the same in both claims and is capable of receiving either decompressed information (claims 14 and 17) or compressed information (claim 17).

The Round 2 Cable and Satellite defendants both contend that the term “subscriber receiving station” is indefinite. Both contend essentially that the term “subscriber receiving station” has no ordinary meaning and is not used in the specification. Both also contend that “subscriber receiving station” cannot have the same or similar meaning as another term, “reception system.”

The construction of the term “subscriber receiving station” is similar to the construction of the term “download component” in *Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353, 1359-1361 (Fed. Cir. 2005). In *Network Commerce,* the claim term “download component” did not appear in the specification and had no ordinary meaning or special meaning in the field of the patent. *Id.*, at 1359-1360. Rather than throw up its hands and find the term “download component” indefinite, as the defendants would have this Court do, the district court and the Federal Circuit both looked to the specification to determine whether a meaning for “download component” could be found there. The Federal Circuit found that the similar term in the specification “download file” corresponded most closely to the download component of the claims:

> In general “the specification necessarily informs the proper construction of the claims” and it is “appropriate for a court . . . to rely heavily on the written description for guidance as to the meaning of claims.” *Id*. at 1317. Here, the specification does not use the term “download component,” presumably because this claim terminology was added during prosecution after the specification had been prepared. The specification does describe a “download file.” It appears from the function and description of the “download file” that this item corresponds most closely to the download component of the claims.

Network Commerce, 422 F.3d at 1360.

Here, the term at issue is “subscriber receiving station,” which appears in claims 14 and 17 as the structure that receives information transmitted from the local distribution system to the subscriber location. The specification refers to a “receiving system” and depicts this in Figure 6. (*See*, ‘863 patent, 3:36-37). It appears from the function and description of the “receiving system” that the “receiving system” is the item that most closely corresponds to the “subscriber receiving station” of the claims. (See, discussion above regarding playback devices).

Both groups of defendants also contend that “subscriber receiving station” cannot have the meaning given to it by Acacia, because the term "receiving system" would have the same or a similar meaning. The Federal Circuit in *Bancorp Servs., LLC v. Hartford Life Insurance Group Co.*, 359 F.3d 1367, 1373 (Fed. Cir. 1996) construed a claim term that was not used in the specification and had no ordinary meaning or special meaning in the field of the patent as having the exact same meaning as another similar claim term that was even used in close proximity to the term in a claim. The Federal Circuit held that, although there is an inference that different claim terms appearing in the same claim should have different meanings, this inference is not conclusive and different words may express the same concepts:

> Hartford is correct that the use of both terms in close proximity in the same claim gives rise to an inference that a different meaning should be assigned to each. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp*., 93 F.3d 1572, 1579 (Fed. Cir. 1996) (stating that if two terms described a single element, "one would expect the claim to consistently refer to this element [with one or the other of the two terms], but not both, especially within the same clause"). That inference, however, is not conclusive; it is not unknown for different words to be used to express similar concepts, even though it may be poor drafting practice.

Bancorp, 359 F.3d at 1373.

9. "Decompressing the Compressed, Digitized Data Representing the at Least One Item of Audio/Video Information After the Transmission Step Wherein the Decompressing Step is Performed in the Local Distribution System to Produce the Representation of the at Least One Item For Transmission To The At Least One Subscriber Station" ('863 Patent, Claim 14)

In its brief, Acacia addressed the portion of the Round 3 defendants' construction which limited the representation of the at least one item to "digital" decompressed data. Acacia explained that the claim is silent as to whether the decompressed data is analog or digital (persons of ordinary skill in the art in 1991 would have understood that decompressed data could either be in analog or digital formats). Acacia also pointed out that transmitting analog information is supported in the specification. ('863 patent, 4:59-61). The Round 3 defendants have not addressed any of Acacia's contentions, but instead have only stated that decompression in one dictionary means the act of expanding data to the length that preceded data compression. While this is correct, the claim still does not include a limitation that the data being transmitted to the subscriber receiving stations is limited to decompressed digital data as opposed to decompressed analog data. The Round 3 defendants seek to import a limitation to the claim and therefore rewrite this claim. This would be improper. *Resonate*, 338 F.3d at 1365 ("Courts may not rewrite claim language based on what has been omitted from the claims, and the district court's attempt to do so here was legal error.")

III. CLAIM 15 OF THE '863 PATENT

10. "Wherein the Inputting Step Comprises Inputting the Item Having Information as Blocks of Digital Data" ('863 Patent, Claims 15, 18)

Only the Round 3 defendants address claims 15 and 18 in their opposition. They contend that this claim is definite, but contend that the fact that the information is input as blocks of digital data means that the transmission system itself does not form the data blocks. They ask that the Court include this limitation in the construction itself.

This limitation is not found in the claims (which include the step of "formatting the item having information as a sequence of addressable data blocks") and therefore the Court should not include this limitation in its construction. *See, e.g., Resonate*, 338 F.3d at 1365 ("Courts may not rewrite claim language based on what has been omitted from the claim, and the district court's attempt to do so here was legal error.")

IV. CLAIM 16 OF THE '863 PATENT

11. "Wherein the Inputting Step Comprises Inputting the Item Having Information as an Analog Signal and Converting the Analog Signal to Blocks of Digital Data" ('863 Patent, Claims 16 and 19)

Only the Round 3 defendants address claims 16 and 19 in their opposition. They contend that these claims are indefinite, because the fact that the inputting step in these claims includes both inputting the item having information as an analog signal and converting the analog signal to blocks of digital data makes the claim contradictory.

Claims 16 and 19 are essentially the same as claims 15 and 18, which the Round 3 defendants contend are definite, except that, instead of inputting digital data blocks, the item is in an analog format which is then converted to create digital data blocks, the same input as in claims 15 and 18. This is exactly what the Round 3 defendants state when discussing the formatting step of claim 17 (Round 3 defendants' Opposition, at 64:3-5: "Finally, if the information is in analog form, it must be converted into digital form after the claimed step of 'inputting an item having information into the transmission system,' but before the step of 'formatting the item having information as a sequence of addressable data blocks.'") Thus, if claims 15 and 18 are definite, then claims 16 and 19 are also definite.

V. CLAIM 17 OF THE '863 PATENT

12. "Formatting Items of Audio/Video Information as Compressed Digitized Data at a Central Processing Location" and "Wherein the Formatting Step Comprises" ('863 Patent, Claim 17)

The Round 3 defendants contend that this phrase requires that "the transmission system ascertain whether the information is already in analog or digital format" and if it is in analog form, "then the transmission system must convert it to digital form." The Round 3 defendants do not seek to merely add a limitation to the claims – they seek to add two steps to the claim, neither of which is present in the claim itself or in the ordinary meaning of these terms. In fact, the limitation of converting the analog information into digital information is contained in the dependant claim 19, and therefore, pursuant to the doctrine of claim differentiation, this limitation cannot be included in independent claim 17. *See, Phillips*, 415 F.3d at 1315, *citing, Liebel-Flarshiem Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) ("[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumptions that the limitation in question is not present in the independent claim.")

The Round 3 defendants contend that these limitations must be included in the claim, because "[t]his is exactly the way the transmission system depicted in Figure 2 operates." (Round 3 defendants' Opposition, at 63:14). The Round 3 defendants are attempting to improperly import limitations into the claims from the specification and therefore are inviting the Court to commit legal error were it to include these limitations. *See, SRI Int'l.*, 775 F.2d at 1121 ("If everything in the specification were required to read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment."); *Teleflex*, 299 F.3d at 1327; *Epcon Gas*, 279 F.3d at 1032; *Resonate*, 338 F.3d at 1365 ("Courts may not rewrite claim language based on what has been omitted from the claim, and the district court's attempt to do so here was legal error.")

13. "Transmitting Compressed, Digitized Data Representing a Complete Copy of at Least One Item of Audio/Video Information at a Non-Real Time Rate From a Central Processing Location" ('863 Patent, Claim 17)

The Round 3 defendants contend that the phrase "a complete copy of at least one item of audio/video information" means "a copy of all of the audio/visual information contained on the at least one physical object." Acacia contends that there is no such limitation in the claims, nor should one be added through claim construction. Acacia's reply to this contention is set forth in Section 1.b., *supra*.

14. "Using the Stored Compressed, Digitized Data to Transmit a Representation of the at Least One Item to at a Plurality of Subscriber Receiving Stations Coupled to the Local Distribution System" ('863 Patent, Claim 17)

a) The Term "Using" is Definite

Only the Round 2 satellite defendants address the term "using" in this phrase and contend that it is indefinite. The Round 2 satellite defendants contend that this term is indefinite, because this phrase does not identify any specific act. This phrase does specify an act – transmitting the representation of the at least one item to the plurality of subscriber receiving stations using the stored compressed, digitized data.

The Round 2 satellite defendants' reliance on *Ex Parte Erlich* is misplaced. In *Erlich*, the claims at issue contained a single phrase having the term "using," i.e., both claims merely stated that they were for a process for using monoclonal antibodies. The Board of Patent Appeals and Interferences held that these claims were incomplete "since they did not recite any steps." *Ex Parte Henry A. Erlich and Linda J. Nyari*, 1986 Pat. App. LEXIS 13; 3 U.S.P.Q. 2d (BNA) 1011, 1012. The Board held that: "[w]hile we agree with appellants that the claims need not recite all of the operating details, we do find that a method claim should at least recite a positive, active step(s) so that the claim will 'set out and circumscribe a particular area with a reasonable degree of precision and particularity.'" *Id.* The lone phrase of these claims was in effect the preamble of the claims. Neither claim recited *any* steps for performing this method.

Here, claim 17 is directed to a "method of distributing audio/video information" and recites numerous positive, active steps ("formatting," "transmitting," receiving," "storing," "inputting," "assigning," "formatting," "using to transmit," and "compressing") for achieving this method.

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

Claim 17 is therefore nothing like the claims in *Erlich,* because it includes numerous active steps for performing the "method of distributing audio/video information."

In their brief, the Round 2 satellite defendants misstate the standard for indefiniteness: "The test of indefiniteness is whether a person of ordinary skill in the art can understand the metes and bounds of the claim." (Round 2 satellite defendants' Opposition, at 26:20-21). The correct standard for determining indefiniteness is whether those of ordinary skill in the art are unable to understand what is claimed *when the claim is read in light of the specification*. *Bancorp*, 359 F.3d at 1372. Using their incorrect statement of the standard for indefiniteness, the Round 2 satellite defendants' pose a series of questions purporting to demonstrate that the claims are indefinite. (Round 2 satellite defendants' Opposition, at 27:1-5). Without the context of the specification, which always must be considered when construing a claim, these questions are meaningless.

The Round 2 satellite defendants next examine the specification, but do so only to look for the words "use" or "using." They then state that: "[t]here is no mention of *using* stored compressed data for the purpose of facilitating transmission." (Round 3 Satellite defendants' Opposition, at 27:11-12; emphasis supplied). This is not true. The specification states that the compressed data is in fact used to transmit a representation of the compressed data. According to the specification, before transmission, a transmission data converter 119 converts the compressed data and this converted data is transmitted:

> The conversion performed by transmission data converter 119 encodes the data for the transmission channel. The transmission data converter transfers the desired segments of data from the compressed data library 118 onto the communication channel which is used to deliver the data to the reception system 200.
>
> The transmission system 100 of the present invention preferably further includes transmitter means 122, coupled to the compressed data library 118, for sending at least a portion of a specific file to at least one remote location. The transmission and receiving system of the present invention preferably operates with any available communication channels. Each channel type is accessed through the use of a communications adaptor board or processor connecting the data processed in the transmission format converter 119 to the transmission channel.

('863 patent, 15:13 – 28; *See also,* Figure 2b).

b) The Phrase "to at a Plurality of Subscriber Receiving Stations"

The Round 3 defendants contend that the phrase "to at a plurality of subscriber receiving stations" is indefinite. The Round 3 defendants contend that there is an error in this claim, which cannot be corrected. Acacia is not asking the Court to correct an error; it asking the Court to interpret the words in the claim.

The *Novo* case cited by the Round 3 defendants is inapplicable. In *Novo*, the patent claim, which included the phrase "stop means formed on a rotatable with," was indefinite. To overcome this indefiniteness, the patentee asked the court to correct the claim language pursuant to 35 U.S.C. §§ 254 and 255 . The court, however, held that it could not correct the claim language, because "the nature of the error is not apparent from the patent itself." *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2003).

Unlike the phrase in *Novo*, the phrase "to transmit a representation of the at least one item of audio/video information to at a plurality of subscriber receiving stations" in claim 17 is not indefinite, because it would have been understood by a person of ordinary skill in the art in 1991, when the claim is read in light of the specification. The person of ordinary skill in the art would have understood this phrase to mean that "a representation of the at least one item is transmitted such that it is received by a plurality of subscriber receiving stations."

The Round 3 defendants contend that there is an error in this claim and therefore this phrase could mean either "transmitting to a plurality of subscriber receiving stations" or "transmitting to at least one of a plurality of subscriber receiving stations." The claim phrase does not use the terms "one" or "at least one," and therefore one of ordinary skill in the art, when reading this claim phrase, would not understand this phrase to refer to one of the plurality of subscriber receiving stations or to refer to at least one of the plurality of subscriber receiving stations. Instead, a person of ordinary skill in the art would see that this phrase refers to "a plurality of subscriber receiving stations." Sending the information to a plurality of users is described in the specification. (*See, e.g.*, '863 patent, 4:51-56).

The Round 3 defendants further contend that the term "at" in the claim phrase means merely the goal of an action, not the action itself. Although Acacia disagrees, even if this is true, then the term “to” provides the action that the Round 3 defendants state is lacking. The Round 3 defendants agree. (Round 3 defendants’ Opposition, at 78:9-10).

The Round 3 defendants also contend that the word “at” is used in other claim phrases to refer to the place where the action is occurring. While this may be true in those other claim phrases, from the context of the claim and when read in light of the specification, this is not the case in claim 17. In claim 17, the term “at” appears in the phrase “using the stored compressed, digitized data to transmit a representation of the at least one item to *at* a plurality of subscriber receiving stations coupled to the local distribution system.” In the claim, the “stored compressed digitized data,” as stated in the immediately prior step, is stored at the local distribution system, not at the subscriber receiving station. Further, in the specification, the audio/video data is always transmitted to the subscriber, never from the subscriber. This is because the object of the invention is to allow the subscriber to access material from their home or other location remote from the transmitting location. One of ordinary skill in the art would therefore understand that this claim phrase, when read in light of the specification, would never require that the audio/video data itself be transmitted from the subscriber back to the transmission system or the local distribution system.

Thus, this claim phrase is not insolubly ambiguous and it is not legally indefinite. *See, Exxon Research and Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) (“If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds. [citations omitted]. By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of patent validity [citation omitted] and we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.”)

15. Whether Each Step of Claims 14 and 17 of the 863 Patent and Claims 8 and 11 of the ‘720 Patent Begin and Occur Only After a Prior Step or Steps Have Been Completed.

As stated in Acacia’s opening brief and in the Round 3 defendants’ opposition, the parties have already addressed the same issue with respect to the steps of the method claims in the ‘992 and ‘275 patents. Acacia has nothing more to add to this issue.

VI. CLAIMS 4, 7, 8, AND 11 OF THE '720 PATENT

16. "Subscriber Selectable Receiving Stations" ('720 Patent, Claims 4, 8, and 11)

The Round 2 satellite defendants contend that the term "subscriber selectable receiving stations" must include the limitation that the choice to be selected must be provided to the subscriber by the reception system (claim 4) or the local distribution system (claims 8 and 11). The Round 2 satellite defendants contend that this limitation is necessary because otherwise, the claim would be vague and these structures are the only structures in the claims that are in communication with or coupled to the subscriber selectable receiving stations.

As discussed in Acacia's opening brief, the Round 2 satellite defendants are improperly adding a limitation to the claim which is not present in the claim. *Resonate*, 338 F.3d at 1365 ("Courts may not rewrite claim language based on what has been omitted from the claim, and the district court's attempt to do so here was legal error.") No such limitation appears in the specification. Indeed, the specification describes many different ways in which the subscriber may be provided the option to select a receiving station, other than via the local distribution system or the receiving system. For example, the user may make a request for transmission using: (1) the "remote order processing and item database" ('720 patent, 11:47-65; 13:33-60; 14:28-45); (2) the library access interface 121 ('720 patent, 12:62 – 13:5); (3) telephone tone decoders ('720 patent, 13:23-32); (4) operator assisted service ('720 patent, 14:8-21). Indeed, the specification never states that the "receiving system" or the "local distribution system" provides the user with this option.

17. "Means, Responsive to the Stored, Compressed Digitized Data, for Transmitting a Representation of the at Least One Item of Audio/Video Information at a Real-Time Rate to at Least One of the Plurality of Subscriber Selectable Receiving Stations" ('720 Patent, Claim 4)

Claim 4 of the '720 patent recites a "means, responsive to the stored, compressed digitized data, for transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations." Acacia proposes that, as is ordinarily the case, the claimed function follows the word "for." That is, the recited function is "transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations." *See Seal-*

Flex, Inc. v. Athletic Track & Court Constr., 172 F.3rd 836, 849 (Fed. Cir. 1999) ("The preposition 'for' colloquially signals the recitation of a function."). The phrase "responsive to the stored, compressed digitized data" is a limitation, but it is not part of the function.

The Round 2 Satellite Defendants, unhappy with the language of the claim, argue that the descriptive phrase "responsive to the stored, compressed digitized data" preceding the word "for" should be included in the function, though they never propose what the function of this element ought to be. Rather, in order to suit their ultimate goal of finding this means plus function term to be indefinite because, as they contend, there is no structure disclosed in the specification that is "responsive to the stored, compressed digitized data" under their construction, the Round 2 Satellite Defendants argue that the language of the claim should be rearranged.[9] Not only is this improper because the words "responsive to the stored, compressed digitized data" appear only before the word "for", but also because the phrase "responsive to the stored, compressed digitized data" does not describe a function at all – it is a characteristic of structure. The phrase "responsive to the stored, compressed digitized data" which the Round 2 Satellite Defendants improperly include in their proposed function by transposing this phrase from before the word "for" to after the clearly recited function, is merely descriptive language that provides environment. *See Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1368, 1372 (Fed. Cir. 2002) (rejecting the dissent's contention by construing the function of the claim term "means connected to said fluid receiver and said source of fresh fluid, for equalizing the fluid flow into said fluid receiver and out of said source of fluid" to be "equalizing fluid flow"); *Micro Chem., Inc. v. Great Plains Chemical Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999) ("Each apparatus claim recites a 'weighing means . . . for' performing a specified function. In claim 74, the properly identified function of this means-plus-function element, signaled by the preposition 'for,' is 'determining the weights of selected additives.'"); *Kinzenbaw v. Case LLC*, 2006 U.S. App. LEXIS 10656 (Fed. Cir. 2006) (unpublished) (reversing district court's claim construction that "connecting said carrier frame to the tractor hitch" was part of the function

[9] The parties' dispute regarding this means-plus-function claim element centers around the identification of the function. Once the function is identified as Acacia proposes, the structure disclosed in the specification for performing that function is easily identifiable.

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

of the claim term "draft tongue means connecting said carrier frame to the tractor hitch for permitting pivotal movement between said tractor and said implement about a first vertical hitch axis" and "connecting said lift frame to said carrier frame" was part of the function of the claim term "powered lift linkage means connecting said lift frame to said carrier frame for lifting said lift frame and said work units above said carrier frame to a raised position wherein all of said units are elevated above said support wheels.")

Defendants cannot identify a single case which permits the court to rearrange the language of the claims in the way they propose. In fact, the law prohibits changing the claim language. *Micro Chem.*, 194 F.3d at 1258 ("The statute does not permit limitation of a means-plus-function claim by adopting a function different from that explicitly recited in the claim."); *Hoganas AB v. Dresser Indus.,* 9 F.3d 948, 950 (Fed. Cir. 1993). The only case that the Round 2 Satellite Defendants appear to cite in support of their argument, *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003), does not support their position at all. In *Lockheed*, the means plus function claim element at issue recited:

> Means for rotating said wheel in accordance with a predetermined rate schedule which varies sinusoidally over the orbit at the orbital frequency of the satellite whereby the attitude of said satellite is offset in response to the effect of said rotating wheel by the direction of the pitch axis being changed with respect to said momentum vector, the direction of said pitch axis with respect to the inclined orbit normal varying sinusoidally at the orbital frequency to null said roll pointing error due to said orbit inclination, the momentum vector being maintained perpendicular to the plane of the geosynchronous orbit to null said yaw pointing error due to said orbit inclination

Id at 1315. The district court construed the function of this means-plus-function element to be "rotating said wheel." *Id* at 1318-19. The Federal Circuit disagreed, and construed the function to be "rotating said wheel in accordance with a predetermined rate schedule which varies sinusoidally over the orbit at the orbital frequency of the satellite." That is, it included additional language appearing after "for" and describing the function which had been omitted by the trial court." *Id* at 1319. The *Lockheed* court did not, as Defendants propose to do here, rearrange the claim language or include in the function language that appeared before the word "for."

18. "Means for Inputting Items of Audio/Video Information" ('720 Patent, Claim 7)

The parties agree that the claim phrase "means for inputting items of audio/video information" is a means-plus-function claim limitation governed by 35 U.S.C. § 112(6), and that the function is "inputting items of audio/video information." In its opening brief, Acacia pointed to the structure that performs that function – the analog input receiver 127 and/or the digital input receiver 124 – and pointed to the portion of the specification that describes these components performing the "inputting" function. (Acacia's Legal Memorandum Re: '863 and '720 Patent Claim Terms, p. 54). But the Round 2 Satellite Defendants still argue that this claim term is indefinite.

The Round 2 Satellite Defendants' argument goes something like this – the digital and analog input receivers (124 and 127 respectively) are in the converter (113), and the converter (113) performs the function of "conversion", so the digital and analog input receivers (124 and 127) cannot be the structure that performs the function of inputting. But this argument has no support in fact or law. The Round 2 Satellite Defendants do not cite a single case (because there is none) that prohibits a single structure from performing two functions. Further, the Round 2 Satellite Defendants ignore the fact that the specification recites specific components within the converter – namely the digital and/or analog input receivers (124 and 127) – that perform the inputting function, and different components – namely an analog audio converter (123a) and analog video converter (123b), or a digital audio formatter (125a) and digital video formatter (125b) – that perform the function of "conversion." In other words, it is not the entire converter 113 that performs the "inputting" function; it is just the digital and/or analog input receivers (124 and 127) that perform that function. The Round 2 Satellite Defendants' selective quotation of this Court's previous opinions out of context cannot change what is disclosed in the specification. Therefore, only these components within the converter (113) are the corresponding structure to this means-plus-function claim element. *Micro Chem.*, 194 F.3d at 1258 ("Nor does the statute permit incorporation of structure from the written description beyond that necessary to perform the claimed function.").

Because the specification describes two alternative structures for inputting items of audio/video information, both fall within the claimed "means." *Micro Chem.,* 194 F.3d at 1258 (When "multiple embodiments in the specification correspond to the claimed function, proper

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

application of § 112, ¶ 6 generally reads the claim element to embrace each of those embodiments."). Specifically, the '720 patent explains that where "items have only one format" (analog or digital) "only [that] one [corresponding] input receiver is necessary." Therefore the structure corresponding to the "means for inputting items of audio/video information" is the digital input receiver 124 or the analog input receiver 127, and their respective equivalents.

Finally, the Round 2 Satellite Defendants argue that the structure described in the specification – the analog input receiver 127 and digital input receiver 124 – and the explanation of those components, are "insufficient to teach one reasonably skilled in the art" what they are. Therefore, the Round 2 Satellite Defendants argue, the means-plus-function claim term is indefinite. But the Round 2 Defendants provide no evidentiary support for their contention, even though it is their burden to do so, nor do they provide any evidence about the level of ordinary skill in the art or how one of ordinary skill in the art would understand the claim language.

As noted in Acacia's previous briefing in this case, a defendant has the extraordinary burden of showing by clear and convincing evidence that a claim term is insolubly ambiguous, in arguing that a claim term is indefinite. *Bancorp*, 359 F.3d at 1372; *S3, Inc. v. nVidia Corp.*, 259 F.3d 1364, 1369 (Fed. Cir. 2001); *Exxon Research*, 265 F.3d at 1375. Courts are instructed, in considering whether a claim is indefinite, to respect the statutory presumption of patent validity and "protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal." *Bancorp*, 359 F.3d at 1372.

Here, the specification describes, in one example, that audio information is input using "an optical or magnetic digital playback device," which is "connected to the digital audio formatter 125a." ('992 patent, 7:40-43). The Round 2 Satellite defendants, however, do not even attempt to meet their burden of showing what one skilled in the art would or would not understand. The Round 2 Satellite Defendants' inability to meet this burden is not surprising, since one skilled in the art at the time this patent application was filed would understand exactly what an analog or digital input receiver was because one was described in the specification and other devices that performed this "inputting" function were readily available at that time.[10]

19. "Conversion Means for Placing Each Item of Audio Video Information Into a Predetermined Format as Formatted Data" ('720 Patent, Claim 7)

The parties agree that the claim phrase "conversion means for placing each item of audio video information into a predetermined format as formatted data" is a means-plus-function claim limitation governed by 35 U.S.C. § 112(6), and that the function is "placing each item of audio video information into a predetermined format as formatted data." In its opening brief, Acacia pointed to the structure that performs that function – the analog audio converter (123a) and the analog video converter (123b), or the digital audio formatter (125a) and digital video formatter (125b) – and pointed to the portion of the specification that describes these components performing the "conversion" function. (Acacia's Legal Memorandum Re: '863 and '720 Patent Claim Terms, p. 56).

But the Round 2 Satellite Defendants insist that the converter (113) is the structure that "plac[es] each item of audio video information into a predetermined format as formatted data." The Round 2 Satellite Defendants' identification of the entire converter (113) as the corresponding structure ignores the fact that the specification recites specific components within the converter (113) – namely an analog audio converter (123a), an analog video converter (123b), a digital audio formatter (125a), and/or a digital video formatter (125b) – that perform the function of "conversion," and different components within the converter (113) perform other functions, such as inputting. In other words, it is not the entire converter (113) that performs the "conversion" function; it is just the analog audio converter (123a) and analog video converter (123b), or the digital audio formatter (125a) and digital video formatter (125b) that perform that function. Therefore, only these components within the converter (113) are the corresponding structure to this means-plus-function claim element. *Micro Chem.*, 194 F.3d at 1258 ("Nor does the statute permit incorporation of structure from the written description beyond that necessary to perform the claimed function.").

The Round 2 Satellite Defendants' selective quotation of this Court's previous opinion out of context cannot change what is disclosed in the specification. Previously, this Court construed the "conversion means" of a different claim – claim 1 of the '992 patent – to have the converter (113) as its corresponding structure. But in that claim, there was no "means for inputting," as in this claim – claim 7 of the '720 patent. Certain specified components within the converter (113) are responsible for the "conversion" function and others are responsible for the "inputting" function that is recited explicitly in claim 7 of the '720 patent. In contrast, the "inputting" function is implicitly part of the "conversion" function of in claim 1 of the '992 patent, since there would be nothing to convert if nothing is inputted. Only those components that are necessary for the "conversion" function of claim 7 of the '720 patent should be incorporated as corresponding structure to the "conversion means" of claim 7 of the '720 patent – not those components that relate only to the "inputting" function that is separately recited.

---

[10] If this Court deems it necessary, Acacia is prepared to present expert testimony to demonstrate that one skilled in the art would understand these terms.

Because the specification describes two alternative structures for "placing each item of audio video information into a predetermined format as formatted data", both fall within the claimed "means." *Micro Chem.*, 194 F.3d at 1258 (When "multiple embodiments in the specification correspond to the claimed function, proper application of § 112, ¶ 6 generally reads the claim element to embrace each of those embodiments."). Specifically, the '720 patent explains that "[w]hen the information … is digital" the digital audio formatter (125a) and digital video formatter (125b) are employed, and "when the retrieved information … is analog" the analog audio converter (123a) and analog video converter (123b) are employed. ('720 patent, 6:56-7:13). As further shown in Fig. 2a, reproduced below, only one of these two alternative structures are used for accomplishing the "conversion" function, depending on the format of the information that is to be converted.

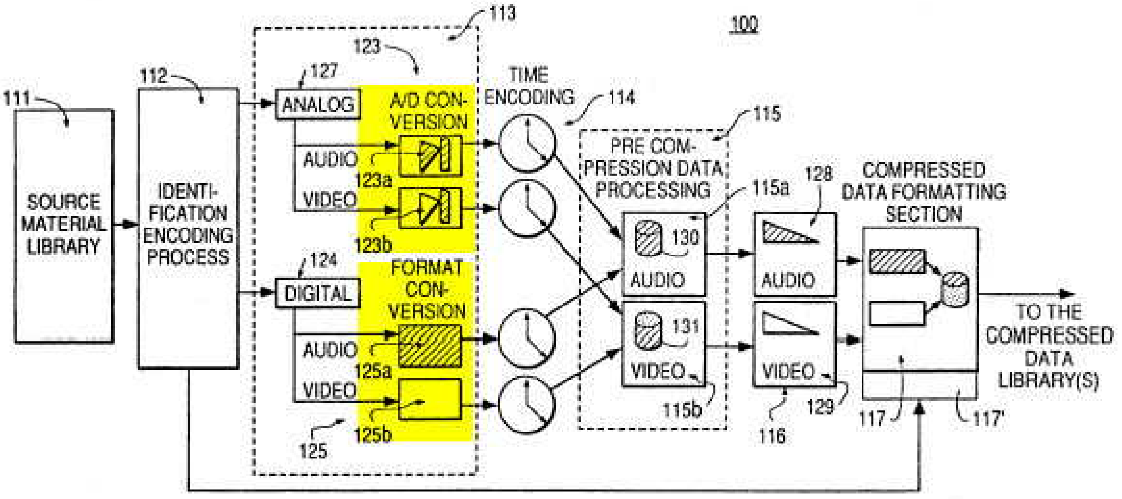
113
100
123
127
112
111
ANALOG
A/D CON-VERSION
TIME ENCODING
114
115
AUDIO
123a
VIDEO
123b
SOURCE MATERIAL LIBRARY
IDENTI-FICATION ENCODING PROCESS
PRE COM-PRESSION DATA PROCESSING
115a
128
COMPRESSED DATA FORMATTING SECTION
130
AUDIO
AUDIO
124
DIGITAL
FORMAT CON-VERSION
131
VIDEO
VIDEO
AUDIO
125a
VIDEO
125b
125
115b
116
129
117
117'
TO THE COMPRESSED DATA LIBRARY(S)

FIG. 2a

20. Transmitter Means for Sending Compressed Formatted Data for the at Least One Item of Audio/Video Information at the Non-Real Time Rate to the Reception System" ('720 Patent, Claim 7)

The parties seem to agree that if "transmitter means" is a means plus function claim limitation, the function is "sending compressed formatted data for the at least one item of audio/video information at the non-real time rate to the reception system." The parties further agree that the structure disclosed for performing that function is the transceiver/transmitter 122. The parties' dispute centers around what examples of the transceiver/transmitter 122 are mentioned in the specification.

Acacia contends that the specification mentions at least seven different examples of a transceiver/transmitter 122: 1) transmitter; 2) transceiver; 3) cable television transmitter; 4) modem; 5) broadcast television transmitter; 6) data coupler; and 7) satellite transmitter. The Round 2 Satellite Defendants concede that the specification mentions "a modem, a data coupler, a transmitter, and a transceiver" as examples of a transceiver/transmitter 122. However, the Round 2 Satellite Defendants insist that the specification makes no mention of 1) a cable television transmitter, 2) a satellite transmitter, or 3) a broadcast television transmitter. But the first two – cable television transmitter and satellite transmitter – are shown in Fig. 2b, shown below (with highlighting):

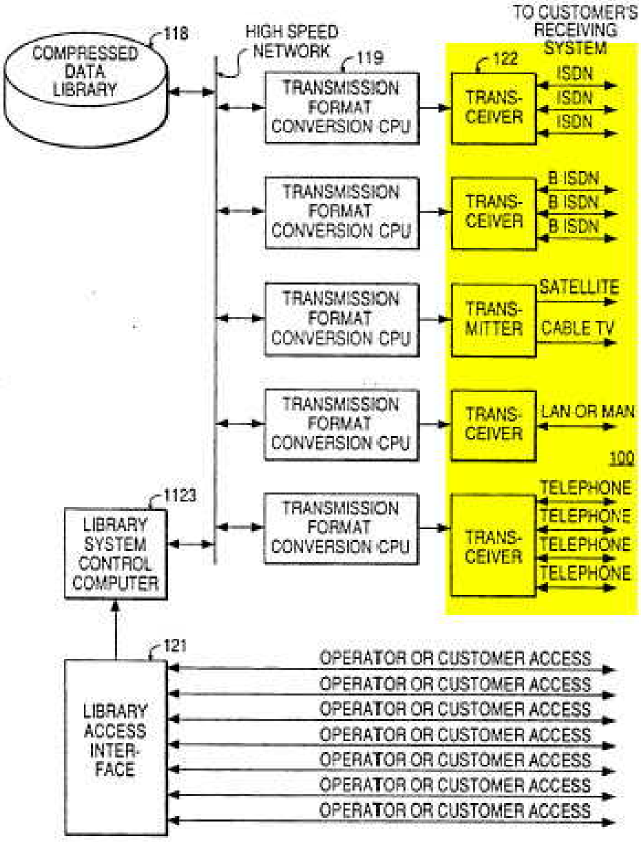
COMPRESSED DATA LIBRARY
118
HIGH SPEED NETWORK
119
TRANSMISSION FORMAT CONVERSION CPU
TO CUSTOMER'S RECEIVING SYSTEM
122
TRANS-CEIVER
ISDN
ISDN
ISDN
B ISDN
B ISDN
B ISDN
TRANS-MITTER
SATELLITE
CABLE TV
LAN OR MAN
100
1123
LIBRARY SYSTEM CONTROL COMPUTER
TELEPHONE
TELEPHONE
TELEPHONE
TELEPHONE
121
LIBRARY ACCESS INTER-FACE
OPERATOR OR CUSTOMER ACCESS

FIG. 2b

Similarly, the specification states that the transmission system "may preferably employ VHF, UHF, or satellite broadcasting systems." ('720 patent, 4:57-59). VHF and UHF would be recognized by anyone with a television in January 1991, when this patent was filed, to be "broadcast television."

21. ". . . Transmitting, Using a Transmitting Means, a Representation of the at Least One Item at a Real-Time Rate to at Least One of a Plurality of Subscriber Selectable Receiving Stations" ('720 Patent, Claim 8)

The parties' dispute over the term "transmitting means" mirrors that of "transmitter means," which is discussed above. Therefore, for the sake of brevity, Acacia will not repeat its arguments. Rather, Acacia refers the court to the previous section.

VII. CLAIM TERMS FROM THE '992 PATENT THAT THE COURT HAS ALREADY CONSTRUED

22. "Transmission System" ('992 Patent, Claims 19 and 41; '275 Patent, Claims 2 and 5; '863 Patent, Claims 14 and 17)

The Round 3 defendants' request that the Court limit the construction of the term "transmission system" in every claim to the embodiment depicted in Figures 2a and 2b of the patents is contrary to law and is not supported by the facts.

a) The Court Did Not Find that the Patentees Disavowed the Ordinary Meaning of "Transmission System," as the Round 3 Defendants Contend

The Round 3 defendants contend that reconsideration of the term "transmission system" is necessary, because they believe that the Court's construction of "transmission system" deviates from the ordinary meaning of "transmission system." (Round 3 defendants' Opposition, at 3-4). From this, the Round 3 defendants infer that the Court found (*sua sponte* and without informing the parties in the Markman I order) that the patentees had disavowed claim scope and given the term "transmission system" a special meaning limited to only the embodiment in Figures 2a and 2b. This was the first time that any party had made such a contention.

Acacia did not understand from the Court's Markman I order that the Court had deviated from the ordinary meaning of the term in construing the term "transmission system" or that the Court had found that the patentees had disavowed claim scope. The Court made no such statements in its Order. It was Acacia's understanding that the Court had construed "transmission system" according to its ordinary meaning, but had added language regarding conversion to a computer compatible form and storage, because the context of the '702 patent specification and claims included these limitations.[11] Acacia's understanding followed from the fact that both sides argued in Markman I that the term "transmission system" should take on its ordinary meaning; the parties only disputed the ordinary meaning to be given the term. No party contended that that term "transmission system" should take a meaning different from its ordinary meaning and no party contended that the patentees had made any disclaimer or disavowal of claim scope. Nor did the

[11] Acacia believes that it is clear from the Court's construction for "transmission system" that it included context specifically from the '702 patent claims. This is because the Court's construction specifically states that the transmission is to "a reception system." Transmission to a reception system is specified in the claims of the '702 patent. Claims 1 and 41 of the '992 patent, which also were at issue in Markman I, do not indicate transmission to a "reception system;" they specify transmission to "remote locations." Further, claim 19 of the '992 patent specifies transmission to a "receiving system." Neither claims 1, 19, or 41 of the '992 patent mention a "reception system." Acacia shall address this in Section No. 22.e., *infra*, where Acacia shall request that the Court reconsider its construction of "transmission system" to delete the reference to "reception system."

Court raise this is an issue at the hearing.

In its Markman I Order, the Court did not state that it was intentionally deviating from the ordinary meaning of the term "transmission system" and it did not identify any statement in the patent or its prosecution history for deviating from the ordinary meaning of the term. (*See*, Markman I, at 27:12 – 28:13). As discussed in more detail below, claim terms are generally given their ordinary and customary meaning, unless the inventor has "demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex*, 299 F.3d at 1325. The Court, in Markman I, did not hold that the patentees demonstrated such an intent nor did it cite to any "expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope."

It was entirely proper for the Court to interpret the term "transmission system" according to the context in which it is used in the claims and the specification, even when giving the term its ordinary meaning. As discussed by the Federal Circuit in *Phillips*, the court may narrow the ordinary meaning of a claim term, *even where there is no explicit disclaimer*, to conform the ordinary meaning of a term to the context of the patent specification, claims, and prosecution history:

> Although the *Texas Digital* line of cases permit the dictionary definition to be narrowed in some circumstances *even where there is not an explicit disclaimer or redefinition in the specification*, too often that line of cases has been improperly relied upon to condone the adoption of a dictionary definition entirely divorced from the context of the written description. The problem is that if the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition, the error will systematically cause the construction of the claim to be unduly expansive. The risk of systematic overbreadth is greatly reduced if the court instead focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history, rather than starting with a broad definition and whittling it down.

Phillips, 415 F.3d at 1321; emphasis added.

b) The Disclosure in the Specification of Only a Single Embodiment Does Not Limit the Claimed Invention to the Features Described in the Disclosed Embodiment

The Round 3 defendants contend that the Court must limit the meaning of "transmission system" to the system depicted in Figures 2a and 2b, because: (1) the term "transmission system" is used in the specification in a manner that is "incompatible" with its plain meaning; and (2) the transmission system of Figure 2 is the only transmission system disclosed in the specification.

In *Phillips*, the Federal Circuit reaffirmed its often stated rule that the "words of a claim 'are generally given [the] ordinary and customary meaning'" that they would have to a person of ordinary skill in the art at the time of the invention. *See, Conoco, Inc. v. Energy & Envtl. Int'l, L.C.*, __ F.3d ___, 2006 U.S. App. LEXIS 21036, at *16 (Fed. Cir. August 17, 2006), *quoting, Phillips*, 415 F.3d at 1312-13. Claims are to be read in light of the specification, and thus an inventor may use the specification to intentionally disclaim or disavow the broad scope of a claim. *Id., citing, Phillips*, 415 F.3d at 1316.

Any intention to disclaim or disavow claim scope, however, must be clear and must be evidenced by "expressions of manifest exclusion or restriction." *Id., citing, Teleflex,* 299 F.3d at 1325 ("The patentee may demonstrate an intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope."). Further, absent such expression, the court is forbidden from importing limitations into the claim from a preferred embodiment or the only embodiment described in the specification. *Id.*, at *17, *citing, Phillips*, 415 F.3d at 1323 ("[W]e have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment."); *See also, CCS Fitness v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) ("An accused infringer may overcome this 'heavy presumption' and narrow a claim term's ordinary meaning, but he cannot do so simply by pointing to the preferred embodiment or other structures or steps disclosed in the specification or prosecution history.")

In their legal brief, the Round 3 defendants contend that the Court should construe the term "transmission system" as being limited to the "only" embodiment disclosed in the specification, which, according to defendants is in Figures 2a and 2b. Figures 2a and 2b do not depict the "only" embodiment disclosed in the specification. For example, the specification includes numerous examples of alternative embodiments. The transmission system may include a single source material library or a plurality of source material libraries, which may be geographically close together or far apart. (‘992 patent, 6:23-34). The specification states that, if materials in the source material library are not already in a format compatible to the inputs of the converter, then those materials must be converted to or recorded on a compatible media format. (’992 patent, 6:8-22). Storage encoding may be performed just prior to conversion, at any time after the conversion, or after storing the item in the compressed data library. (‘992 patent, 6:43-47). The transmission system may either be located in one facility or may be spread over a plurality of facilities. (‘992 patent, 5:61-63). The identification encoder may allow entry of a popularity code. (‘992 patent 12:28-57). The transmitter may be a modem or a data coupler, of other type of transmitter depending on the type of transmission channel selected. (“992 patent, 16:58-17:5). Other examples of alternative embodiments for the transmission system exist in the specification.

The Federal Circuit has on numerous occasions rejected the very same argument being made by the Round 3 defendants. For instance, in *Leibel-Flarshiem*, the accused infringer *Medrad* argued that, “because all the embodiments described in the common specification of the ‘669 and ‘261 patents feature pressure jackets, the claims of those patents must be construed as limited to devices that use pressure jackets.” *Leibel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d at 898, 905-906 (Fed. Cir. 2004). The Federal Circuit rejected this contention outright and stated that the claims would be limited to the single embodiment only if the patentees, in the specification or the file history, demonstrated a clear intention using “words or expressions of manifest exclusion or restriction” to confine the claimed invention to that embodiment.

> [T]his court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. See *ACTV, Inc. v. Walt Disney Co*., 346 F.3d 1082, 1091 (Fed. Cir. 2003); *Apex Inc. v. Raritan Computer, Inc*., 325 F.3d 1364, 1377 (Fed. Cir. 2003); *Altiris, Inc. v. Symantec Corp*., 318 F.3d 1363, 1373 (Fed. Cir. 2003); *Tex. Digital Sys., Inc. v. Telegenix, Inc*., 308 F.3d 1193, 1204-05 (Fed. Cir. 2002); *Teleflex, Inc. v. Ficosa N. Am. Corp*., 299 F.3d 1313, 1327 (Fed. Cir. 2002); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 n.14 (Fed. Cir. 1985) (en banc). Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using “words or expressions of manifest exclusion or restriction.” *Teleflex*, 299 F.3d at 1327.

Leibel-Flarsheim, 358 F.3d at 906.

In *Leibel-Flarsheim*, the Federal Circuit found that the specification and file history did not include the disavowal statements necessary to limit the claims and thus the court would not limit the scope of the claims to the single embodiment in the specification:

> In this case, the specification does not describe the invention as limited to embodiments having pressure jackets, and none of the other reasons that have been invoked for giving claims a narrow reading are present. Although all the embodiments described in the common specification of the ‘669 and ‘261 patents include a pressure jacket, the written description does not contain a clear disavowal of embodiments lacking a pressure jacket. Medrad relies on several passages from the specification in which the applicants described an embodiment that uses a pressure jacket. Those passages, however, do not expressly or by clear implication restrict the scope of the invention to injectors using a pressure jacket.
>
> * * *
>
> This case is therefore governed by the principle that “absent a clear disclaimer of particular subject matter, the fact that the inventor may have anticipated that the invention would be used in a particular way does not mean that the scope of the invention is limited to that context.” *Northrop Grumman*, 325 F.3d at 1355; *accord Brookhill-Wilk*, 334 F.3d at 1301; *Teleflex*, 299 F.3d at 1328.

Leibel-Flarsheim, 358 F.3d at 908-909; *See also*, *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1331-1332 (Fed. Cir. 2004) (“Nor do we find the disclosure of a single embodiment to be limiting in this case. An applicant is not necessarily required by 35 U.S.C. § 112, ¶ 1 to describe more embodiments than its preferred one, and we have outright rejected the notion that disclosure of a single embodiment necessarily limits the claims.”); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371 (Fed. Cir. 2003) (“Looking next to the written description, it clearly only discusses a single ‘preferred’ embodiment in which the ‘setting’ step occurs after the ‘testing’ step and before the ‘booting normally’ step. Nowhere, however, is there any statement that this order is important, any disclaimer of any other order of steps, or any prosecution history indicating a surrender of any other order of steps.”)[12]

[12] *See also*, *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003); *Gemstar –TV Guide Int’l, Inc. v. United States Int’l Trade Comm’n*, 383 F.3d 1352, 1365-66 (Fed. Cir. 2004); *Fuji Photo Film Co. v. United States Int’l Trade Comm’n*, 386 F.3d 1095, 1106 (Fed. Cir. 2004); *CCS Fitness*, 288 F.3d at 1367-68; *Harold Schoenhaus v. Genesco, Inc.*, 440 F.3d 1354, 1358 (Fed. Cir. 2006); *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1374 (Fed. Cir. 2005);

Hennigan, Bennett & Dorman llp
lawyers
los angeles, california

c) There is no Expression in the Specification or Prosecution History that the Patentees Intended to Limit "Transmission System" to the Embodiment in Figures 2a and 2b

The Round 3 defendants do not point to any specific, explicit statement in the patent specification or the prosecution history which would demonstrate that the patentees intended to limit the meaning of "transmission system" to the specific transmission system depicted in Figures 2a and 2b. For the Court to *exclude* from the claims *all* transmission systems *except* for the one shown in Figures 2a and 2b requires that the patentees have made a clear statement that they intended to limit the "transmission system" to only this embodiment. Absent such a statement, the Court cannot use the patentees' silence to narrow the ordinary meaning of an unambiguous claim term:

> Here, on the other hand, nothing in the specifications distinguishes the claimed "member" from prior art based on its shape or number of components. And the specifications do not even imply that "all embodiments" of the claimed exercise machine must use a single-component, straight-bar member or else tout the advantages of using that particular structure. In short, Life Fitness cannot use the intrinsic evidence's silence to narrow the ordinary meaning of an unambiguous claim term. *See, e.g., Johnson Worldwide*, 175 F.3d at 992, 50 USPQ2d at 1612 ("Mere inferences drawn from the description of an embodiment of the invention cannot serve to limit claim terms."); *Kegel*, 127 F.3d at 1427, 44 USPQ2d at 1127 ("Without an express intent to impart a novel meaning to a claim term, the term takes on its ordinary meaning."); *see also Wang Labs*, 197 F.3d at 1384, 53 USPQ2d at 1165-66 (limiting term "frame" to the character-based system in the specification when (among other things) the prosecution history distinguished the claimed invention from prior art based on that system).

CCS Fitness, 288 F.3d at 1368 (Fed. Cir. 2002).

In this case, there is no evidence in the specification or file history that the patentees have demonstrated a clear intention using "words or expressions of manifest exclusion or restriction" to limit the term "transmission system" to only the system exactly as depicted in Figure 2. The Round 3 defendants can do no better than pointing to the fact that: (1) the title of the patents includes the term "transmission system;" (2) the invention is characterized as a "transmission system" "repeatedly throughout the specification;" and (3) the inventors "characterized" the "invention" as a "transmission system" in the Petition to Make Special. (Round 3 defendants' Opposition, at 6:18 – 7:10). None of these are evidence of "words or expressions of manifest exclusion or restriction."

First, the title of the patent is not limiting. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309, 1312-13 (Fed. Cir. 1999) (a patent's title is irrelevant to claim construction).

Next, the use of the term "transmission system" to "characterize" the invention in the patent is not an example of "words or expressions of manifest exclusion or restriction." The Round 3 defendants intentionally ignore the many places where the specification makes clear to the reader that the patentees did *not* intend to limit the transmission system in the claims to the system depicted in Figure 2. The patentees specifically stated in the specification that all of the Figures are merely preferred embodiments, only intended to explain the principles of the invention:

> The accompanying drawings, which are incorporated in and constitute a part of the specification, illustrate the presently preferred apparatus and method of the invention and, together with the general description given above and the detailed description of the preferred embodiment given below serve to explain the principles of the invention. In the drawings:
>
> * * *
>
> FIGS. 2a and 2b are detailed block diagrams of preferred implementations of the transmission system of the present invention;

('992 patent, 3:17-24 and 3:28-30).

Thus, the transmission system of Figures 2a and 2b is merely a preferred embodiment of the invention. Of course, the court is forbidden from importing the preferred embodiment into the claims. *Electro Medical Sys., S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1054 (Fed. Cir. 1994).

The patentees even state that Figures 2a and 2b do not necessarily depict the only embodiment of the invention:

> FIGS. 2a and 2b illustrate detailed block diagrams of preferred implementations of the transmission system 100 of the present invention. Transmission system 100 may either be located in one facility or may be spread over a plurality of facilities. *A preferred embodiment of transmission system 100 may preferably include only some of the elements shown in FIGS. 2a and 2b.*

('992 patent, 5:59-65; emphasis added).[13]

The Round 3 defendants attempt to avoid this statement by arguing that the specification does not say which components are required and which are not. The specification describes many of the elements of the Figure 2 transmission as being optional ("may" include) or being "preferred."[14] (*See*, '992 patent, 5:66-68; 6:8-10; 6:55-62; 7:59-63; 8:57-66; 10:17-22; 13:29-34; 15:61-16:6; and 17:54-66).

---

[13] There is no legal requirement that the patentees describe every conceivable and possible embodiment of their invention. *See, CCS Fitness*, 288 F.3d at 1366 ("[O]ur case law makes clear that a patentee need not 'describe in the specification every conceivable and possible future embodiment of his invention.'"), *quoting, Rexnord Corp. v. The Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001) ("In short, it is the claims that measure the invention, as informed by the specification. As we noted long ago: 'Specifications teach. Claims claim.'"), *quoting, SRI Int'l*, 775 F.2d at 1121.

The patentees further informed readers of their specification that the description in the patent was merely exemplary and not intended to limit the scope of the invention:

> Other embodiments of the invention will be apparent to those skilled in the art from consideration of the specification and practice of the invention disclosed herein. It is intended that the specification and examples be considered as exemplary only, with the true scope and spirit of the invention being indicated by the following claims.

('992 patent, 20:6-12); *See, Rexnord Corp. v. Laitram Corp.,* 274 F.3d 1336, 1345, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (finding no disclaimer of claim scope: "Finally, the inventor explicitly qualified his detailed 'Description of A Preferred Embodiment' by stating that 'it is intended to be understood that the invention is not limited in its application to the details of construction and the arrangements of components set forth in the following description or illustrated in the drawings.").

Thus, it is clear that the patentees were setting out in their specification specific *examples* of the invention, rather than limiting the claims to the embodiments in the specification or even the embodiment of Figures 2a and 2b. *See, Phillips*, 415 F.3d at 1323 ("Much of the time, upon reading the specification in that context [teaching a person of ordinary skill in the art how to make and use the invention], it will become clear whether the patentee is setting out specific examples of the invention to accomplish those goals, or whether the patentee instead intends for the claims and the embodiments in the specification to be strictly coextensive.")

Consistent with the drawings being merely exemplary are the examples of alternative embodiments set forth in the specification, some of which are described above.

In addition to the language above from the specification which indicates the patentees' intent

---

[14] The Round 3 defendants' reliance on *Irdeto Access, Inc. v. EchoStar Satellite Corp.*, 383 F.3d 1295, 1302 (Fed. Cir. 2004) is misplaced, because in *Irdeto*, unlike this case, the patentee had admitted that the claim terms lacked any meaning in the art and directed the examiner and the public to the specification for the source of meaning for the disputed terms.

Hennigan, Bennett & Dorman LLP
Lawyers
Los Angeles, California

to encompass transmission systems in addition to the transmission system depicted in Figures 2a and 2b, every claim of the Yurt patents in which the term "transmission system" appears uses the open-ended term "comprising" (even claim 1 of the '992 patent, which specifically claim "a transmission system *comprising* . . ."). This fact also demonstrates the patentees' intent to not limit the term "transmission system" in the claims to Figures 2a and 2b. *See*, *Gillette*, 405 F.3d at 1374 ("This patent and its prosecution record fall far short of any kind of disclaimer or disavowal. Not only did the patentee claim the invention with two open-ended terms ('comprising' and 'group of'), but the specification expressly teaches that the invention encompasses a 'plurality of blades.'")

Claim 1 of the '992 patent is additional strong evidence that the patentees did not intend to limit the term "transmission system" to the embodiment of Figures 2a and 2b. Claim 1 of the '992 patent, which was part of the originally-filed patent application is for "a transmission system comprising . . ." The elements of claim 1 are written in means-plus-function format. The means-plus-function elements of claim 1 do *not* specify *only* the structures depicted in Figures 2a and 2b, because means-plus-function claim terms are interpreted to cover the structures disclosed in the patent specification *plus* all equivalents. Further, claim 1 lacks some of the structures identified in Figures 2a and 2b, such as the precompression processors 115, the transmission format conversion CPU 119, the library system control computer 1123, and the library access interface 121. If the patentees had intended the term "transmission system" to mean only the system in Figures 2a and 2b, then there would be no need for claim 1, or for any of its dependent claims. *See, SRI Int'l*, 775 F.2d at 1121 ("If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, then there would be no need for claims.")

Lastly, the Round 3 defendants' quote from the PTMS is not "words or expressions of manifest exclusion or restriction," because the patentees did not state, or even infer, in the PTMS that the transmission system was limited to the system depicted in Figures 2a and 2b.[15]

---

[15] The cases cited by the Round 3 defendants are distinguished from *Liebel* and are distinguished from the present case. (*See*, Round 3 defendants' Opposition, at 3-17). In each case cited by the defendants, the patentees demonstrated a clear intention to limit the claim scope using "words or

As there is no evidence demonstrating that the patentees had an intent to deviate from the ordinary and accustomed meaning of "transmission system," the Court must construe the term "transmission system" to have its ordinary meaning. *See*, *Teleflex*, 299 F.3d at 1328 ("The specification describes only one embodiment of the claimed 'clip (28),' but in the circumstances of this case the record is devoid of 'clear statements of scope' limiting the term appearing in claim 1 to having 'a single pair of legs.' Absent such clear statements of scope, we are constrained to follow the language of the claims, rather than that of the written description."); *Brookhill-Wilk*, 334 F.3d at 1301-02 ("Where, as here, the written description and prosecution history fail to express a manifest exclusion or restriction limiting the claim term, and where the written description otherwise supports the broader interpretation, 'we are constrained to follow the language of the claims,' *Teleflex*, 299 F.3d at 1328, 63 USPQ2d at 1382-83, and to give the claim term its full breadth of ordinary meaning as understood by persons skilled in the relevant art. *Rexnord Corp.*, 274 F.3d at 1342, 60 USPQ2d

---

expressions of manifest exclusion or restriction."

The case of *Inpro II Licensing, S.A.R.L. v. T-Mobile USA, Inc.*, 450 F.3d 1350, 1354-55 (Fed. Cir. 2006) is distinguished, because, in construing the claim term "host interface" to be limited to "a direct parallel bus interface," the court found that the only host interface described was a direct parallel bus interface *and* found expressions of manifest exclusion in both the specification and the prosecution history: "the specification emphasizes the importance of a parallel connection in solving the problems of the previously used serial connection;" "The description of a serial connection in the discussion of the expansion bus interface, and the lack of any such description in the discussion of the host interface, reinforce the interpretation of the host interface as requiring a parallel bus interface, for that is the only interface described for that purpose. The specification characterizes the direct bus interface as a 'very important' feature of the invention, stating that a 'direct' connection is necessary to provide 'direct' access, which allows for fast communication."; and "The prosecution history supports the interpretation of 'host interface' as a direct parallel bus interface. In prosecuting the first in this series of applications, the applicants explained that their invention overcame certain limitations of known PDA devices."

The Federal Circuit distinguished the other cases cited by the Round 3 defendants on the grounds that, in those cases, there was evidence that the inventors intended to limit their claims. In *Leibel-Flarsheim*, 358 F.3d at 908, the court stated that "In those cases [including *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295, 1300-01 (Fed. Cir. 1999) and *Modine Mfg. Co. v. United States, Int'l Trade Comm'n*, 75 F.3d 1545, 1551 (Fed. Cir. 1996)], the court interpreted the pertinent claim language narrowly, not merely because the specification, claim, or prosecution history made clear that the invention was not limited to a particular structure. The court in *Leibel-Flarsheim*, 358 F.3d at 907 also stated that "the prosecution history of the patent in suit in *Wang [Labs., Inc. v. America Online, Inc.*, 197 F.3d 1377, 1383 (Fed. Cir. 1999)] showed that the inventors disclaimed a claim construction that would encompass bit mapped display systems. *Id.* at 1383-84. *Wang* therefore does not stand for the proposition that if a patent specification describes a particular embodiment, the claims must be limited to that subject matter."

at 1854.

d) The Term "Transmission System" is not Indefinite

The Round 3 defendants also contend that, if the Court does not adopt their construction for "transmission system" as the embodiment in Figures 2a and 2b, then the Court's present construction for "transmission system" would be indefinite. The Round 3 defendants contend that the term would "insolubly ambiguous." This is nonsensical, because the term has an ordinary meaning and the Court has construed the term and thus it cannot be "insolubly ambiguous."

The Round 3 defendants contend that, under the Court's construction for "transmission system," defendants cannot determine whether their system is a transmission system.[16] Infringement is for a later date. Further, this concern has been addressed by the Federal Circuit, which has held that a claim is definite, and therefore satisfies 35 U.S.C. § 112, ¶ 2, if the claim, read in light of the specification, apprises those skilled in the art of the scope of the claim. *Smithkline Beechham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1339-1340 (Fed. Cir. 2005). Thus, "the test for indefiniteness does not depend on a potential infringer's ability to ascertain the nature of its own accused product to determine infringement, but instead on whether the claim delineates to a skilled artisan the bounds of the invention." *Smithkline Beechum*, 403 F.3d at 1341, *citing*, *Miles Lab. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993).

The Round 3 defendants appear also to be concerned that the Court's construction of "transmission system" would be overly broad. The Federal Circuit has held, however, that claim "breadth is not indefiniteness." *Smithkline Beechum*, 403 F.3d at 1341.

e) Acacia Requests Reconsideration of the Court's Construction of "Transmission System" to Remove the "Reception System" from the Court's Construction

Acacia respectfully requests reconsideration of the construction of the term "transmission system" to remove the "reception system" from the Court's construction. As discussed above in Section No. 22.a., Acacia believes that it is clear from the Court's construction for "transmission

[16] The Round 3 defendants are being quite disingenuous. Although they contend that the term "transmission system" would be indefinite, they do not contend that the term "reception system," which is construed by the Court to be even broader than "transmission system," is not indefinite.

system" that it included *context* specifically from the '702 patent claims. This is because the Court's construction specifically states that the transmission is to "a reception system." Transmission to a reception system is specified in the claims of the '702 patent. This context, however, does not apply to other claims which also use the term "transmission system." Claims 1 and 41 of the '992 patent, which also were at issue in Markman I, do not indicate transmission to a "reception system;" they specify transmission to "remote locations." Further, claim 19 of the '992 patent specifies transmission to a "receiving system." Neither claims 1, 19, or 41 of the '992 patent mention a "reception system."

Thus, because the term "transmission system" is used in claims 1, 19, and 41 of the '992 patent, and because these claims do not specify transmission to a "reception system," Acacia respectfully requests that the Court reconsider its construction of the term "transmission system" to remove the reference to the "reception system," which applies in the context of the '702 patent, but not in the other claims.

This would also be consistent with the Court's construction of "reception system," wherein the Court did not specify that the "reception system" only receives information from the "transmission system." (Markman I, 28:15-23).

23. "Reception System" ('275 Patent, Claims 2 and 5)

Acacia contends that it is improper to add a limitation to the term "reception system" that the "reception system" only receives information "directly" from the transmission system. In its opening brief, Acacia cited a number of cases demonstrating that adding such a limitation to this term would be improper. One of the cases, *Resonate*, 338 F.3d at 1365, was on point and directly contrary to the Round 3 defendants' construction. In *Resonate*, the Federal Circuit held that a patentee's choice not to specify a transmission path in a claim meant that the court could not add a limitation that the material be transmitted *directly*. The Round 3 defendants do not even address this case in their opposition. In *Resonate*, the claim phrase was "transmitting the requested resource to the client." The Federal Circuit did not limit this phrase at all, let alone stating that it had to be limited to directly transmitting to the client. Thus, the Federal Circuit would not have been persuaded by defendants' argument that the fact that the claims in this case refer to sending to the "reception system" requires that the transmission be direct so as to exclude sending to a system "X," because the "direct" limitation is not included in the claims. It would therefore be improper for the Court to add the "direct" limitation to this term.

Acacia further contends that it would be improper to add the limitation of "electronically or optically" to the construction of "reception system." This limitation does not belong in the construction of "reception system." This limitation is not part of the ordinary meaning of "reception system." Besides, this limitation is already included in the claims via the term "sending" in claims 2 and 5 of the '275 patent and the term "in data communication with" in the '702 patent claims.

The Round 3 defendants further contend that the "receiving system" in claims 2 and 5 of the '275 must be limited to a device on which playback can occur. Acacia addressed this contention in its Reply Brief regarding the '992 and '275 patents, at 58:16-59:19, wherein Acacia stated that the specification makes clear that the receiving system is not the playback device. (*See,* '275 patent, 18:36-39 and Figure 6).

24. "Storing Items Having Information in a Source Material Library" ('992 Patent, Claim 41)

a) The Court Construed the Term "Source Material Library" in Markman I to Mean "a Collection of Existing Materials"

The Round 3 defendants premise their arguments that the "source material library" has to mean a litany of elements and limitations not contained in the claims, because "[t]he Court never separately construed 'source material library.'" (Round 3 defendants' Opposition, at 14:16 and 15:7-9). The Court did construe the term "source material library:"

> The Court finds that the plain and ordinary meaning of the term "library" could mean either a collection of books or a place where books could be stored. The specification supports defining library to be a collection of original material, which contains analog or digital information, that the transmission system may convert, compress, and transmit. *In other words, the specification defines the source material library as a collection of original sources of information.* In the transmission system described in claim 41 of the '992 patent, the Court construes the phrase "storing items having information in a *source material library*" to mean "adding items having information to *a collection of existing materials*."

(Markman I, at 25:11-19; emphasis added).

In contending that the Court did not construe the term "source material library," the Round 3 defendants refer to the Court's discussion of the term "library means for storing items containing information" of claim 1 of the '992 patent. The Court's comments regarding a "source material library" were in response to Acacia's contention that the term "library" in the phrase was sufficient structure for performing the claimed function. The Court held that the term "library" was not sufficient structure for performing the claimed function, because the passages from the specification referred to by Acacia did not refer to a "library," but instead referred to a "source material library." The Court's comments in footnote 5 regarding *Lang* merely demonstrated that, consistent with the specification, the patentees referred to a "source material library" when distinguishing *Lang*.

b) The Round 3 Defendants Misquote the Specification

The Round 3 defendants contend that the term "source material library" does not have a plain meaning and contend that the specification and other intrinsic evidence describe a number of specific functions that the source material library must perform. In other words, the Round 3 defendants contend that the patentees defined the term "source material library" in the specification to include all of these features. (*See,* Round 3 defendants' Opposition, at 18:12-20). As with the "transmission system" term discussed above in Section No. 22, the Round 3 defendants have not shown that the patentees have "demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex*, 299 F.3d at 1325. As described below, the patentees made no such statements or expressions.

For instance, the Round 3 defendants state that "[a] source material library ***must*** be capable of storing different types of physical objects containing information. . ." (Round 3 defendants' Opposition, at 18:15-16, *citing*, '992 patent, 6:10-15). The Round 3 defendants are misquoting the patent specification, which does *not* state that being capable of storing different types of physical objects is mandatory:

> The source material library 111 ***may*** include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects.

(‘992 patent, 6:10-15; emphasis added).

Thus, the patentees did not define the “source material library” in the specification to be required to store different types of physical objects containing information and thus Court was correct to not include this limitation in its construction of “source material library.”

The Round 3 defendants further state that “the source material library ***must*** be capable of electronically receiving requests from users which identify the physical objects stored in the source material library.” (Round 3 defendants’ Opposition, at 18:17-20). Defendants refer the Court to its May brief as support, however, nothing in their May brief demonstrates that the patentees stated that the source material library *must* have this capability. Nothing in the specification or in defendants’ briefing even mentions “electronically receiving requests” or “initiating the automated process of retrieving the information from the physical objects identified in the user requests” and defendants cannot support adding these limitations to the meaning of source material library.

Further, nothing in the specification requires that all user requests for transmission of items be sent to the source material library. Although there is an embodiment in the specification in which the user’s request is sent to the source material library, other embodiments in the patent specification teach that the user’s request is sent to the library access interface, which is in communication with the compressed data library, as depicted in Figure 2b and described in the specification of the ‘992 patent at 13:29-47 (E.g., “The transmission system 100 of the present invention may also preferably include library access/interface means for receiving transmission requests to transmit items and for retrieving formatted data blocks stored in the compressed data library 118 corresponding to the requests from users.”)

The fact that Figures 2a and 2b do *not* depict a user request being placed to the source material library, but instead depict the user request being placed to the library access interface demonstrates the fallacies in the Round 3 defendants’ contentions regarding both the “transmission system” and the “source material library.” The fact that the patentees described an embodiment in the specification in which the user request is placed to the source material library, but did not depict this embodiment in Figures 2a or 2b, demonstrates that the patentees did not intend to limit the “transmission system” to the embodiment in Figures 2a and 2b. Similarly, the fact that the patentees described and illustrated an embodiment in which the user request is sent to the compressed data library, via the library access interface, also demonstrates that the source material library is not required to be capable of receiving user requests.

The Court was correct to not include this limitation in its construction of "source material library."

c) Nothing in the Specification or the Prosecution History Teaches that the Source Material Library is a "Jukebox-Like" Device

The Round 3 defendants contend that the patent specification teaches that the "source material library" is a "jukebox-like device." The specification does not use the terms "jukebox" or "jukebox-like" and the Round 3 defendants do not define what they mean by "jukebox-like."

The Round 3 defendants rely on the arrows in Figure 2a as demonstrating that the "source material library" must be "jukebox-like." Figure 2a does not limit the meaning of "source material library." *See, Prima Tek*, 318 F.3d at 1148-49 ("Similarly, the mere fact that the patent drawings depict a particular embodiment of the patent does not operate to limit the claims to that specific configuration."); *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1342 (Fed. Cir. 2001) ("These drawings are not meant to represent 'the' invention or to limit the scope of coverage defined by the words used in the claims themselves."); *TI Group Auto. Sys. v. VDO N. A., LLC*, 375 F.3d 1126, 1136 (Fed. Cir. 2004) ("'the mere fact that the patent drawings depict a particular embodiment of the patent does not operate to limit the claims to that specific configuration.'"), *quoting*, *Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1306-07 (Fed. Cir. 2000).

In Section (a) of their three-section discussion as to why the "source material library" is "jukebox-like," the Round 3 defendants appear to contend that the source material library is "jukebox-like," because the output from the source material library must be a physical object. The Round 3 defendants state that "[t]he single arrow from the source material library to the identification encoder is not labeled as analog or digital because it indicates the transfer of a physical object from the source material library to the identification encoder." The Round 3 defendants' offer no support whatsoever for this statement.

It does not follow from the fact that there is a single arrow from the source material library to the identification encoder in Figure 2a that that the materials from the source material library are only physical items. Figure 2a is a conceptual block diagram which is described in the patent as being only exemplary. (‘992 patent, 3:17-34). In other words, persons of ordinary skill in the art would not view Figure 2a as being limiting or being literally followed in every system. Thus, a “single” line is merely exemplary; the invention can still be practiced with two or three or four lines, etc. without deviating from the invention. Further, persons skilled in the art would have understood that analog and digital *electronic* items can pass through a single “line,” just as physical items could. Indeed, there is no requirement that the source material library store both analog and digital materials; it could store one kind, or both. (‘992 patent, 6:62-68).

Regardless, as Acacia has pointed out many times before, the specification does *not* limit the items stored in the source material library to “physical items:” “The items of information [stored in the source material library] may include analog and digital audio and video information as well as physical objects such as books and records which require conversion to a compatible media type before converting, compressing and storing their audio and video data in the compressed data library means.” (‘992 patent, 6:2-7).

In Section (b) of their discussion, the Round 3 defendants contend that the statement in the specification that retrieving information is “analogous to taking books off a shelf” “suggests a jukebox-like system in which the source material library retrieves the physical object in response to the user request identifying the physical object.” (Round 3 defendants’ Opposition, at 20:9-15). This sentence does not suggest a jukebox. A jukebox does not operate with books or in a library. Further, nothing in this sentence mentions that the books selected are the books identified in a user request that was sent electronically.

In Section (c) of their discussion, the Round 3 defendants contend that there is a telecine device in the identification encoder 112. The specification makes no mention of such a device being part of the identification encoder, but defendants somehow glean this from the specification. According to the defendants, the telecine is between the source material library 111 and the converter 113. Therefore, because Figure 2a shows only the identification encoder between the source material library and the converter, the telecine must be in the identification encoder. This just does not follow. The functions of the identification encoder are never described in the specification as converting a film into digital video (one of the functions of a telecine).[17] One of ordinary skill in the art would not expect Figure 2a to include the telecine, which would not have been part of the identification encoder, because having a film in the source material library is only one of many possible embodiments of the invention.

The prosecution history also does not support construing the "source material library" as a jukebox-like device, as the Round 3 defendants contend. "The prosecution history may demonstrate that the patentee intended to deviate from a term's ordinary meaning, i.e., if it shows the applicant characterized the invention using words or expressions of manifest exclusion or restriction during the administrative proceedings before the Patent and Trademark Office." *Teleflex*, 299 F.3d at 1326. A disclaimer of claim scope requires "clear and unmistakable statements of disavowal." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1358 (Fed. Cir. 2003).

The patentees did not use any clear and unmistakable words or expressions of manifest exclusion or restriction during prosecution which would mean that the source material library is limited to a "jukebox-like" device which automatically transfers physical items in response to an electronically-received request which identifies the physical item. The Round 3 defendants point to three statements regarding *Lang*, however, none of these statements referred to the source material library as a "jukebox-like" device or even stated or inferred that the source material library automatically transfers physical items or receives electronic requests. (Round 3 defendants' Opposition, at 21:7 – 22:6). There is no basis *at all* for the defendants' conclusion that "[w]hat Yurt was telling the examiner, then, was that he had solved the problem of how to incorporate a jukebox-like device into a system which had components similar to those disclosed in *Lang*," because Yurt said no such thing.

d) There is Written Description for the Method Step of "Storing Items Having Information in a Source Material Library"

The Round 3 defendants contend that, because claim 41 of the '992 patent was not part of the

[17] In its Markman II Order, the Court identified ten functions of the identification encoder, but none include the functions of a telecine. (Markman II, at 15:13-16:9).

originally-filed patent application, there is no support in the specification for "putting items having information *into* the source material library." The Round 3 defendants are relying on the fact that the Court construed the method step of claim 41 of "storing items having information in a source material library" to mean "*adding* items having information to a collection of existing materials" together with the fact that the statement in the preamble of claim 41 that the method is "performed by a transmission system."

There is support for this step in originally-filed claim 1, which is part of the specification and therefore the written description requirement is met. *See, e.g., Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989 (Fed. Cir. 2000) (finding support for each claim element in the specification or originally filed claims); *In re Gardner*, 480 F.2d 879 (C.C.P.A. 1973) (finding that an "original claim … in itself constituted sufficient description in the original disclosure … to satisfy the description requirement") (quotations omitted). The originally-filed application for the '992 patent included claim 1. Originally-filed claim 1 described a transmission system having a "library means for storing items:"

> 1. A transmission system for providing information to remote locations, the transmission system comprising:
>
> ***library means for storing information;***
>
> identification encoding means for retrieving the information for the items from the library means and for assigning a unique identification code to the retrieved information;
>
> conversion means, coupled to the identification encoding means, for placing the retrieved information into a predetermined format as formatted data;
>
> ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks;
>
> compression means, coupled to the ordering means, for compressing the formatted and sequenced data;
>
> compressed data storing means, coupled to the data compression means, for storing as a file the compressed, sequenced data received from the data compression means with the unique identification code assigned by the identification encoding means; and
>
> transmitter means, coupled to the compressed data storing means, for sending at least a portion of a file to one of the remote locations.

(Exhibit 13 to Block Suppl. Decl.)

Claim 1, being part of the originally-filed patent application, is part of the originally-filed specification and therefore can provide written description support for any later-added claims. *Union Oil*, 208 F.3d at 998 n.4 (Fed. Cir. 2000) ("One of this court's predecessor court clarified that disclosure in an originally filed claim satisfies the written description requirement."), *citing In re Gardner*, 480 F.2d 879, 880 (C.C.P.A. 1973*); In re Application of Koller*, 613 F.2d 819, 823-24 (C.C.P.A. 1980). *In re Application of Koller* is particularly instructive on this point. In that case, the USPTO Board of Appeals had rejected certain claims based on their conclusion that they were not supported by an adequate written description in the grandparent application to the application at issue. *Id* at 821. The court, however, reversed the Board's decision, reasoning that the later added claims at issue were "of similar scope and wording" as the original claims, and since the "original claims constitute their own description," the added claims are supported. *Id* at 823-24.

When the patentees added claim 41 to the '992 patent application, they informed the examiner that claim 41 corresponded to claim 1 in order to obtain method coverage:

> Applicants also have added independent claims 41, 47, and 54 which correspond generally with independent claims 1, 18, and 22, in order to obtain full apparatus and method coverage consistent with the coverage provided by the original claims.

(Amendment, dated September 30, 1991, at 17; Exhibit 14 to Block Suppl. Decl.)

Thus, the patentees intended that claim 41 would be a method claim having coverage that is consistent with that of claim 1. Claim 41 includes the method step of "storing items having information in a source material library." This phrase is nearly the same as the "library means" phrase of original claim 1. Both phrases use the term "storing" and both refer to items. Both also refer to a library: claim 1 refers to a "library means" (which the Court construed to mean a "source material library") and claim 41 refers to a "source material library."

There is written support for the claim 41 phrase "storing items in a source material library" in the claim 1 phrase "library means for storing items." The claim 1 phrase and the claim 41 phrases essentially claim the same thing, which is what the patentees intended as evidenced by their statement to the examiner. *In re Application of Koller*, 613 F.2d 819, 823-24(C.C.P.A. 1980).

e) Acacia Seeks Reconsideration of the Court's Construction of "Storing Items in a Source Material Library" So as to Conform the Meaning of "Storing" Throughout the Claims to Mean "Adding or Maintaining"

Acacia respectfully requests that the Court modify its construction of the term "storing" in this phrase to be consistent with its use in the specification and to conform the Court's construction

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

of "storing" in claim 1 of the '992 patent.

In its Opening Brief, Acacia cited to the definition for "store" from Webster's dictionary, which recited the acts of both "adding" and "maintaining." Another definition in Websters' for the word "store," when used as a verb is "hold". As set forth in the IEEE Dictionary, the verb "store" has three possible meanings: (1) to place data into a device into which data can be placed, in which they can be retained, and from which they can be retrieved (i.e., the act of adding data); (2) to retain data in a device into which data can be placed, in which they can be retained, and from which they can be retrieved (i.e., the act of maintaining data); or (3) to place or retain data in a storage device.[18] (IEEE Dictionary, Exhibit 15 to Block Supp. Decl.)

In its opening brief, Acacia suggested modifying the construction for "storing" to be "adding and maintaining." However, for the Court to construe the term "storing" in claim 41 to be consistent with the specification and consistent with the Court's construction of storing in claim 1, the construction should be "adding items having information to or maintaining items having information in a collection of existing materials."

Adding items to the source material library is not a requirement of the specification and therefore it should not be a requirement of claim 41. When describing the "source material library" in the specification of the patent, the patentees described the "source material library" in terms of "maintaining" items:

> Transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for temporary storage of items prior to conversion and storage in a compressed data library means.
>
> * * *
>
> The source material library 111 may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects.

('992 patent, 5:66-6:2 and 6:10-15).

---

[18] In their opposition, in response to Acacia, the Round 3 defendants stated that "'storing' items involves maintaining the items stored." (Round 3 defendants' Opposition, at 3, n. 1). Thus, the Round 3 defendants agree that "storing" involves the act of "maintaining the items stored."

The specification also describes the "preferred method of distribution." ('992 patent, 18:46-47). Claim 41 is for a method of distribution. In this section of the specification, the patentees assumed that the items were already stored in the source material library:

> As illustrated in FIG. 7, *the first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111*, upon a request by a user of the distribution system (step 412).

('992 patent, 18:53-56; emphasis added).

Consistent with these descriptions in the specification and consistent with construing "storing" as "adding or maintaining," there is no arrow in Figure 2a showing that items having information are added to the source material library. A person skilled in the art therefore could understand Figure 2a as presuming that the items are maintained in the source material library.

In Markman I, the Court construed the phrase "library means for storing items having information." The Court stated that the function of the library means is "storing items containing information," however it did not construe the term "storing" to mean "adding items containing information." (*See*, Markman I, at 11:5). The Court construed the term "storing" differently in claim 41 than it did in claim 1. Specifically, the Court stated that the phrase "storing items having information in a source material library" means "adding items having information to a collection of existing materials." (Markman I, at 25:17-19).

Thus, consistent with the specification and with the Court's construction of "storing" in claim 1, the Court should construe the term "storing" as "adding or maintaining." See, *Renishaw, PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998); *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005).

Acacia respectfully requests that the Court reconsider its construction for the phrase "storing items having information in a source material library" as "adding items having information to or maintaining items having information in a collection of existing materials."

25. "Items Containing (or Having) Information" ('992 Patent, Claims 19 and 41; '275 Patent, Claims 2 and 5; '863 Patent, Claims 14 and 17)

a) The Court Should Not Limit the Phrase "Items Having Information to "Physical Objects"

The Round 3 defendants contend that the Court should construe the term "items having information" to mean "physical objects." Like so many other terms for which the defendants ask the Court to import limitations not contained in the claims or in the ordinary meaning of the terms, the do not point to any "expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex*, 299 F.3d at 1325. The Court is therefore "constrained to follow the language of the claims." *Teleflex*, 299 F.3d at 1328 ("Absent such clear statements of scope, we are constrained to follow the language of the claim.")

The Round 3 defendants appear to concede that the ordinary meaning of "items having information" would include physical objects as well as non-physical objects. This is why the Round 3 defendants must instead contend that the specification describes the items in the source material library as being physical objects, citing the '992 patent at 6:2-22. This, however, is not the case. At 6:2-7, the patentees stated that the items of information stored in the source material library may include analog and digital audio and video information, in addition to physical objects:

> Transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for temporary storage of items prior to conversion and storage in a compressed data library means. ***The items of information may include analog and digital audio and video information as well as physical objects*** such as books and records which require conversion to a compatible media type before converting, compressing and storing their audio and video data in the compressed data library means.

('992 patent at 5:66-6:7 emphasis added).

This is hardly an expression of manifest exclusion or restriction, representing a clear disavowal of claim scope limiting the meaning of items having information to physical objects and therefore the Court must give this term its ordinary meaning. *See, Teleflex*, 299 F.3d at 1325.

The Round 3 defendants further contend that the amendment to claim 19 during prosecution in which the word "information" was changed to "items containing information" precludes Acacia's construction of "items having information." Interestingly, the Round 3 defendants do not contend that this amendment is a disavowal of claim scope such that the patentees limited the meaning of "items having information" to physical objects, nor could they.

The Round 3 defendants further contend that "there is nothing in the specification to suggest that an 'item containing information' may be a virtual (i.e., an imaginary) object such as a computer file, which is nothing more than a unit of information which is stored on a physical medium."

Hennigan, Bennett & Dorman LLP
Lawyers
Los Angeles, California

Defendants ignore two facts. First, the specification states that the media formats in the source material library include "disks," obviously referring to computer disks. ('992 patent, 6:13-14). Persons of ordinary skill in the art would certainly have known in 1991 that information is stored on computer disks in the form of computer files. Clearly, then the specification does not preclude an item having information from being a computer file and in fact its supports this. Indeed, storing the items having information in the source material library as computer files on a computer disk would be entirely within the description in the specification. For instance, the specification states that the "items of information may include . . . digital audio and video information." ('992 patent, 6:2-3).

Computer files are described elsewhere in the specification as the manner for storing compressed information in the compressed data library. (*See, e.g.*, 10:17-30). "Files" are also described in claim 41.

The Court therefore should *not* re-write the claim term "items having information" to be limited only to "physical objects."

b) The Patent Specification is Enabled

The Round 3 defendants contend that the Court erred by limiting "items having information" to only information that is in an analog or digital format. The Court explained that it was limiting "items" in this manner, because it believed that the patentees themselves had limited items in this manner to "preserve the validity of the patent." (Markman I, at 11:9-11). The Court did not cite to any portion of the intrinsic evidence or find any facts that would demonstrate that the patentees either (1) believed that they needed to limit the meaning of "items" to "preserve the validity of the patent"; or (2) made an expression of manifest exclusion or restriction, representing a clear disavowal of claim scope to limit "items having information" to only information that is in an analog or digital format. Enablement is an ultimate conclusion of law resting upon factual determinations and is triable by a jury. *See, BJ Servs., Inc., v. Haliburton Energy Servs.,* 338 F.3d 1368, 1372 (Fed. Cir. 2003) ("Although enablement is a question of law, because of the factual nature of the inquiry in this case, it is amenable to resolution by the jury."). Thus, the Court could not have made a finding of enablement without having a jury find facts supporting the legal conclusion of non-enablement or determining on a motion for summary judgment that no genuine

Hennigan, Bennett & Dorman llp
lawyers
los angeles, california

issues of material fact exist that the patent is not enabled.

Perhaps the Court's statement can be explained by the fact that, the Court was construing the claim term "identification encoding means," and thus its task was to find corresponding structure in the specification for the claimed functions. The Court expressed this when it stated in footnote 6 on page 11 of its Markman I Order that: "[n]either the claims nor the specification of the '992 patent disclose any structure for converting information in the 'items' to analog or digital form as required by the 'conversion means,' before the items are stored in the library means."

The patent specification does in fact disclose a structure for converting item of information into digital information. Specifically, the specification describes the example of a film. A film, like a book, does not contain analog or digital information that would be compatible to the inputs of the converter 113. Thus, as the specification states, the film must "be converted to or recorded on a media format compatible to the digital and analog inputs of the system prior to being compressed and stored in a compressed data library 118." ('992 patent, 6:15-19). The specification states that the film is converted to a digital format for input to the digital input receiver 124 of the converter using a telecine:

> If, for example, the retrieved information to be converted from the source material library 111 is a motion picture film, the picture frames in the film are passed through a digital telecine device to the digital input receiver 124.

('992 patent, 7:35-39).

Interestingly, the Round 1 defendants, in their Markman I briefs, had no trouble understanding that the items in the source material library that are not in an analog or digital format are converted to such a format. They even understood that this step occurs before the information is retrieved and understood that this step is not included in the claims, because this step is not always necessary:

> Thus, according to the patent, "items" are physical objects[19] such as audio and video tapes, books, documents, computer disks, and computer tapes. Some of these items contain analog or digital information that is compatible with the analog and digital inputs 124 and 127 of the conversion means 113 shown in FIG. 2a of the '992 patent, and some do not. For those that do not, such as

---

[19] Acacia disagrees with the Round 1 defendants' statement that the "items" are physical objects.

> books for example, the information is converted or recorded to a different media format that is compatible with the system.[7]
>
> [7] The step of "converting to a compatible media format" does not appear in the claims of the '992 patent because the patent explicitly discloses that it is not always necessary. This "converting" step occurs before the information is retrieved by the "identification encoding means" and is not the conversion step that appears in claims 1 and 41. ('992 patent at 6:15-22) ("The items of information may include . . . [20]physical objects such as books and records which require conversion to a compatible media type before converting, compressing and storing . . .") (emphasis added).

(Fish and Richardson defendants' (Round 1) Opposition re Markman I, at 13:14-28; Exhibit 16 to Block Suppl. Decl.).

The fact that the patent specification describes one structure for converting an item having information (a film) to a compatible digital format, but does not describe other structures for converting books or musical instruments does not mean that the patent is not enabling, as the Round 3 defendants contend. In their brief, the Round 3 defendants never state the Federal Circuit standard for enablement: "A decision on the issue of enablement requires determination of whether a person skilled in the pertinent art, using the knowledge available to such a person and the disclosure in the patent document, could make and use the invention without undue experimentation." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 941 (Fed. Cir. 1990). If defendants were to later bring a motion for non-enablement, Acacia will demonstrate that, under the Federal Circuit standard for enablement, the patent is enabled. Acacia therefore reserves the right to address any enablement issues, at trial or when an appropriate motion on the issue of enablement is brought.

26. "Remote Locations" ('992 Patent, Claim 41)

Although the Round 3 defendants indicated in the Joint Claim Chart that it was seeking reconsideration of the term "remote locations," the Round 3 defendants do not address this term in their legal brief. Therefore, Acacia shall presume that the Round 3 defendants have withdrawn their request for reconsideration of the term "remote locations."

---

[20] It is worth noting that the Round 1 defendants deleted the phrase from their quote which supports construing "items having information" as not being limited to physical items: "The items of information may include *analog and digital information as well as* physical objects such as books and records . . ." ('992 patent, at 6:2-4).

27. "Retrieving the Information in the Items from the Source Material Library" ('992 Patent, Claim 41)

In Markman I, the Court construed the term "retrieving" in the claim 1 "means-plus-function" phrase – "identification encoding means for retrieving the information in the items from the source material library and for assigning a unique identification code to the retrieved information" – according to its ordinary meaning to mean "to get something back."

The Round 3 defendants contend that the Court's construction is incorrect, because the Court has not construed the "source material library." As discussed above in Section No. 24.a., the Court did construe the "source material library" in Markman I as "a collection of existing materials."

As a result, the Round 3 defendants contend that the method step of claim 41 – "retrieving the information in the items from the source material library" – includes additional numerous limitations: (1) an electronically transmitted request be sent to the source material library, (2) the identification encoder extracts the information from the physical object, and (3) the identification encoder requires that the identification encoder ascertain whether the information in the item is in analog or digital format, and, if not, the identification encoder converts the information into analog or digital format.

The Court cannot add these limitations to the claim, because: (1) these limitations are not stated in the claim; (2) persons of ordinary skill in the art would not have understood these limitations to have been within the ordinary meaning of any of the claim terms; (3) there is no evidence in the intrinsic record that the patentees clearly intended to limit the claim scope using "words or expressions of manifest exclusion or restriction;" and (4) method claims recite acts, not structure. The legal arguments are the same as those presented above in Section 22.b.

The Round 3 defendants contend that their construction is correct, because the "source material library" is a "jukebox-like" device. It is not, as Acacia discussed above in Section No. 24.

The Round 3 defendants other arguments regarding the specification do not require the Court to construe "retrieving" in the manner they seek. While the Court is required to examine the specification in construing "retrieving," the Court is not required, nor even permitted, to import limitations from the specification into the claims. *Electro-Medical,* 34 F.3d at 1054. Further, although the Round 3 defendants cite to the specification, they do not point to any "expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex,* 299 F.3d at 1325. The Court is therefore "constrained to follow the language of the claims." *Teleflex,* 299 F.3d at 1328 ("Absent such clear statements of scope, we are constrained to follow the language of the claim.") This is exactly what the Court did. (Markman I, at 13:3: "The Court gives the term 'retrieve' its ordinary meaning.")

The Round 3 defendants contend that the Court observed in its construction that it is the identification encoder that gets back the information stored on the physical items. (Round 3 defendants' Opposition, at 30:23-24). The Court did *not* find that the identification encoder gets back information. Rather, the Court was addressing the means-plus-function term – "identification encoding means" – from claim 1 of the '992 patent. Thus, the Court was not interpreting the term "identification encoder," and it did not hold that the "identification encoder" gets back information from the items. In fact, in Markman II, the Court was asked to construe the term "identification encoder." In its Order, the Court found that the identification encoder performs ten functions. (Markman II, at 15:13 – 16:9). None of the ten functions included extracting information from the item. (*Id.*) The Court further distinguished the claims of the '702 patent, which are apparatus claims, from claim 41 of the '992 patent, which is a method claim, which "discloses identification encoding not as an apparatus, but as a step in a method." (Markman II, at 16:10-25).

The Court also did not state that the items were limited to "physical items," as the Round 3 defendants contend.

The Round 3 defendants further contend that the specification "confirms" that it is the "identification encoder" that does the retrieving, citing 2:30-31 of the '992 patent. This portion of the specification does not "confirm" that the identification encoder does the retrieving; instead, this portion states that the "*identification encoding means*" retrieves information: "identification encoding means for retrieving the information for the items from the source material library means and assigning a unique identification code to the retrieved information." ('992 patent, 2:30-31). This language from the "summary" section of the patent tracks the language of claim 1 of the '992 patent.

The Round 3 defendants further contend that "the identification encoder must ascertain whether the information extracted from the item is already in analog or digital form. If it is not, the identification encoder must convert into analog or digital format." (Round 3 defendants' Opposition, at 31:18-21). The Round 3 defendants do not cite to the specification as support for this proposition. As discussed above, the Court in Markman II recited ten possible functions of the identification encoder, but did not find that ascertaining whether information is analog or digital or converting information is a function of the identification encoder.

a) The '992 Patent is Enabled

The Round 3 defendants contend that the "retrieving" step of claim 41 of the '992 patent is not enabled. Enablement is an issue arising under 35 U.S.C. § 112, ¶ 1 and therefore it is not relevant to claim construction or to whether the patent claims are indefinite under 35 U.S.C. § 112, ¶ 2. *See, Personalized Media Communis., LLC v. United States Int'l Trade Comm'n*, 161 F.3d 696, 706-707 (Fed. Cir. 1998) ("We conclude that the evidence relied upon by the Commission [regarding enablement] does not indicate imprecision of the claims. Instead, it is relevant, if at all, only the sufficiency of the written description to enable the practice of the invention of the claims, which is a ground of invalidity under 35 U.S.C. § 112, ¶ 1")

Acacia addresses the Round 3 defendants' non-enablement arguments in Section No. 25.b., *supra*, and Acacia incorporates that section herein and otherwise reserves its rights to address any non-enablement arguments that the defendants may raise at a later date.

28. "Assigning a Unique Identification Code to the Retrieved Information" ('992 Patent, Claim 41)

The Round 3 defendants contend that the Court's construction of this phrase has to be modified to state that this method step is performed by an identification encoder. The Round 3 defendants contend that this is the proper construction, because the term "transmission system" is construed to be the system depicted in Figures 2a and 2b and the component of this system that assigns unique identification codes is the "identification encoder."

The term "transmission system" is not limited to the system of Figures 2a and 2b, as discussed by Acacia above in Section No. 22. Further, the Court should not add a structural limitation to a method step, where none is specified in the claim itself. *See, Epcon Gas*, 279 F.3d at 1032. Indeed, in Markman II, the Court specifically distinguished claim 41 of the ‘992 patent, a method claim, from the claims of the ‘702 patent, which are apparatus claims, on the basis that the apparatus claims require structure, whereas the method claims describes steps. Specifically, the Court stated that the phrase in claim 41 “assigning a unique identification code to the retrieved information” does not disclose an apparatus, it discloses a step in a method:

> Apparatus claims cover what a device is, not what a device does. *See, Hewlett Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). Figure 2a contains a block diagram designated “112” and labeled “IDENTIFICATION ENCODING PROCESS.” A label entitled “Encoding Process” is more indicative of a *method* claim than it is of an apparatus claim. Indeed, the ‘992 patent, which is based on the same specification as the ‘702 patent, contains a method claim 41 which discloses identification encoding ***not as an apparatus, but as a step in a method*** [specifically referencing the step of claim of 41 of “assigning a unique identification code to the retrieved information.”]

(Markman II, at 16:11-17; bold emphasis added).

29. “Placing the Formatted Data into a Sequence of Addressable Data Blocks” (‘992 Patent, Claim 41)

a) The Court Has Construed the Phrase “Sequence of Addressable Data Blocks”

Acacia was surprised to read that the Round 3 defendants contend that the Court has not construed the phrase “sequence of addressable data blocks.” (Round 3 defendants’ Opposition, at 37:21). In the Joint Claim Chart of the Parties’ Proposed Definitions for the Claim Terms from the ‘992 and ‘275 patents, the Round 3 defendants stated that “’[s]equence of addressable data blocks’ is a term which the Court has already construed, meaning that TWC and CSC will be heard as to the construction of this term during the August 11, 2006 Markman hearing.” (Joint Claim Chart, Document No. 186, at 7-8).

The Round 3 defendants contend that, in construing the phrase “ordering means for placing the formatted data into a sequence of addressable data blocks” in claim 1 of the ’992 patent, the Court did not construe, nor did it even need to construe, the phrase “placing formatted data into a sequence of addressable data blocks.” In construing a means-plus-function claim term, the Court must first construe the meaning of the claimed function.[21] Thus, the Round 3 defendants are wrong when they state that there was no reason for the Court to construe the phrase "sequence of addressable data blocks."

It is clear from the Court's Markman I Order, that the Court construed the phrase "sequence of addressable data blocks" to mean time encoded data blocks. The Court stated that the function of the ordering means is "placing items into a sequence of addressable data blocks" and stated that the "corresponding structure of the ordering means is the 'time encoder (Figure 2a (114)." (Markman I, 22:16-19). In fact, the Court cited to two passages from the '992 patent, which demonstrate that the Court interpreted "sequence of addressable data blocks" to mean time encoded data blocks:

> The transmission system 100 of the present invention also preferably includes ordering means for placing the formatted information into *a sequence of addressable data blocks*. As shown in FIG. 2a, the ordering means in the preferred embodiment includes time encoder 114. After the retrieved information is converted and formatted by the converter 113, the information may be time encoded by the time encoder 114. Time encoder 114 places the blocks of converted formatted information from converter 113 into a group of addressable blocks. *The preferred addressing scheme employs time encoding*.

('992 patent, 7:59 – 8:2; emphasis added).

> *The sequence of addressable data blocks which was time encoded and output by time encoder 114* is preferably sent to precompression processor 115.

('992 patent, 8:59-62; emphasis added).

b) The Phrase "Sequence of Addressable Data Blocks" Does not Have any Ordinary Meaning; the Patentees Acted as Their Own Lexicographers

The Round 3 defendants contend that the Court must construe the phrase "sequence of addressable data blocks" by separately construing each of the constituent terms of the phrase. This was the approach proposed by the Round 1 defendants at Markman I. (*See,* Fish and Richardson

[21] *Golight*, 355 F.3d at 1333-34 ("The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. … we construe this function according to its ordinary meaning … . The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function.") (quotations and citations omitted); *also see JVW Enters., Inc. v. Interact Accessories, Inc.*, 424 F.3d 1324, 1330-31 (Fed. Cir. 2005) ("Determining a claimed function and identifying structure corresponding to that function involve distinct, albeit related, steps that must occur in a particular order. In short, function must be determined before corresponding structure can be identified.")

Claim Construction Brief re ‘992 patent terms at 38-39; Exhibit 17 to Block Suppl. Decl..). The Court rejected this approach in construing the phrase “sequence of addressable data blocks.” (Markman I, at 22:15-21 and 23:2-5).

The fact that the Court did not construe this phrase by separately construing each constituent term of the phrase means that the Court found that the phrase was defined in the specification. In *Phillips*, the Federal Circuit stated that the specification “acts as a dictionary when it expressly defines terms used in the claims *or when it defines terms by implication*.” *Phillips*, 415 F.3d at 1321 (emphasis added), *citing*, *Vitronics*, 90 F.3d at 1582; *Irdeto*, 383 F.3d at 1300 (“Even when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.”) (citations omitted); *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334-35 (Fed. Cir. 2004) (same); *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc*., 262 F.3d 1258, 1268 (Fed. Cir. 2001) (“[A] claim term may be clearly redefined without an explicit statement of redefinition.”).

c) The Term “Addressable” in the Phrase “Sequence of Addressable Data Blocks” Does Not Refer to Addressability in the Compressed Data Library

Parsing the terms of the phrase “sequence of addressable data blocks,” the Round 3 defendants contend that the term “addressable” in this phrase refers to the physical address of the data blocks when they are stored in the compressed data library. (Round 3 defendants’ Opposition, at 39:17-18). Neither the claims nor the specification support finding that “addressable” in this phrase refers to a physical address in the compressed data library.

The phrase “sequence of addressable data blocks” appears in claim 41 of the ‘992 patent. At the last Markman hearing, the parties informed the Court that they agree that the steps of claim 41 are performed in the order recited in the claim. Thus, the step of “placing the formatted data into a sequence of addressable data blocks” occurs *before* the step of compressing and occurs *before* the step of “storing, as a file, the compressed, formatted, and sequenced data blocks.” The “storing” step is when the data blocks are actually stored in the compressed data library. Before the storing step ever occurs, however, the so-called “addressable” data blocks must be compressed, and therefore must be addressable whilst in the compressor and when they are output from the compressor and prior to being stored as a file in the compressed data library. The time codes, which are added in the earlier step of "placing the formatted data into a sequence of addressable data blocks," provide this addressability.

The specification also makes clear that "addressable" in the phrase "sequence of addressable data blocks" does not mean a physical address in the compressed data library. First, nothing in the specification actually states or infers that "addressable" in the phrase "sequence of addressable data blocks" refers to a physical address in the compressed data library. The Round 3 defendants ignore the fact that the specification states, in reference to "sequence of addressable data blocks" that the addressing scheme is "time encoding;" the specification does not refer to the physical address in the compressed data library as the addressing scheme. (*See*, '992 patent, at 8:1-2: "The preferred addressing scheme employs time encoding.")

The specification also makes clear that time encoding (the addressing scheme) makes items and subsets of items of addressable, not only in the compressed data library, but *throughout the transmission system*:

> Time encoding by time encoder 114 makes itmes [sic] and subsets of items retrievable and addressable throughout the transmission system 100.

('992 patent, 8:50-52).

This is confirmed by another portion of the specification which states that "user and system addressing requirements" (not compressed data library addressing requirements) are provided using the "frame addresses" and "frame numbers"[22]:

> *User and system addressing* requirements dictate the level of granularity available to any particular section of the system. Users are able to move through data in various modes, thus moving through the *frame addresses* at various rates. . . .*Internal to the system*, the song is associated with a starting frame number, which was indexed by the system operator via the storage encoding process.

The Round 3 defendants contend that time encoding makes the data blocks addressable

---

[22] The Round 3 defendants contend that the "frame numbers" are equivalent to time codes. (Round 3 defendants' Opposition, at 41:16 – 42:3).

"because it can be used as an offset from the starting address which was assigned by the identification encoder." (Round 3 defendants' Opposition, at 39:21-40:1). The "starting address" is the file address used to store the file in the compressed data library. While the "starting address" may be useful for locating data blocks in the compressed data library, it is useless for locating data blocks in any other portion of the transmission system.

The specification describes other uses of time coding which relate to addressability, but have nothing to with a physical address in the compressed data library. For example, the patentees understood that the audio and video portions of the audio/video data would be separately time encoded and separately compressed. Following compression, the separate compressed audio and video data would need to be reunited and realigned in such a manner that the voice and picture are synchronized *prior* to storing in the compressed data library. The system uses the time codes to realign the audio and video. ('992 patent, 8:2-6). This is another example of the use of time codes for addressability, apart from the physical address in the compressed data library.

The Round 3 defendants contend further that time encoding is not the only way to achieve addressability. (Round 3 defendants' Opposition, at 40, n. 20). They contend that the patent states that non-video or audio information, such as books, may be used with the system and these types of materials are incompatible with time encoding. The patent specification does not exclude books from time encoding. Further, the time markers that are described in the specification are not described as being limited to the real time of the audio and video (i.e., they are not "absolute" time markers). In other words, nothing in the patent states that the time markers for a two hour movie must start at time zero and end exactly at two hours. Instead, the patent only states that the time markers need only be "*relative* time markers." ('992 patent, at 8:16-19). In the case of a book, the images of the book's pages may be converted to a digital format comprising digital data bytes (depicted in Figure 8c). These digital data bytes[23] may then be passed to the time encoder, where

---

[23] Persons of ordinary skill in the art would have known that when audio, video, and books are converted to a digital format for processing by the time encoder, they would all comprise digital data bytes. (See, '992 patent, 8:7-10). At this level, the time encoder would not be able to distinguish between the digital data bytes of video, audio, or a book; they would all look the same to the time encoder.

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

"relative time markers" (not absolute time markers) are assigned. Nothing in the specification would prohibit the time encoder from assigning relative time markers to the data bytes of the book.

In fact, the patentees contemplated that materials, such as books, would be time encoded, just like audio and video information. For example, in the cited passage below, the patent specification states that frames or groups of frames, which may represent book pages, may be subsets of the items stored in the compressed data library. These items and subsets of items are retrievable and addressable using "time codes." Thus, the patent specification explicitly states that book pages may be time encoded:[24]

> The system item database may contain information records for individual frames or groups of frames. These can represent still frames, chapters, songs, *book pages*, etc. The frames are a subset of, and are contained within, the items stored in the compressed data library 118. Time encoding by time encoder 114 makes itmes and subsets of items retrievable and addressable throughout the transmission system 100.[25]

('992 patent, at 8:45-52).

The Round 3 defendants further contend that "time encoding" relates to the "addressability" part of the phrase "sequence of addressable data blocks," because the data blocks were "already placed into a sequence before time encoding." (Round 3 defendants' Opposition, at 42:10-11). It is indisputable that *time* is a sequence. The specification states that the "incoming signals are inputted and converted [by the converter] in sequence, starting with the first and ending with the last frame of the video data and starting with the first and ending with the last sample of the audio data." ('992 patent, 8:12-16). The sequence is provided by the relative time markers, not the fact that the frames are converted from the first one to the last one. This is evidenced by the claim 41's use of the phrase "sequenced data blocks." "Sequenced" refers to the fact that the data blocks are in a "sequence of

[24] This directly contradicts the Round 3 defendants' statement that "Books, documents, and photographs, unlike audio tracks and video images, cannot be time encoded." (Round 3 defendants' Opposition, at 46:10-11).

[25] Time encoding materials other than audio and video, such as books, makes sense. If this system uses time codes for transmitting audio and video information, then this system could also be used to transmit books as well. Rather than reconfigure the system to use something other than time codes just for the books, the patentees contemplated using time codes for books as well. Thus, their system would be more robust than other systems, because it could transmit and receive books in addition to audio and video.

addressable data blocks".

d) A "Data Block" is a Frame of Video or a Sample of Audio

By taking every instance where the term "data block" or "block" is ever used in the patent specification or in the prior art, the Round 3 defendants give the term "data block" in the phrase "sequence of addressable data blocks" a construction that the patentees never intended or described.

While the patent specification does use the term "data blocks" to describe many different types of data blocks, it is clear from the specification that, in the phrase "sequence of addressable data blocks," the patentees intended "data blocks" to refer to frames of video, samples of audio, and frames of data. The Federal Circuit held in *Pitney Bowes*, 182 F.3d at 1311 that where the specification has different uses of a term, in a claim, that term will be given the meaning that it has in the proper context in the specification:

> In circumstances such as this, where the language of the written description is sufficient to put a reader on notice of the different uses of a term, and where those uses are further apparent from publicly-available documents referenced in the patent file, it is appropriate to depart from the normal rule of construing seemingly identical terms in the same manner. This entirely accords with the public notice function of claims. *See Vitronics*, 90 F.3d at 1583, 39 U.S.P.Q.2D (BNA) at 1577; *Hoganas AB v. Dresser Indus*., 9 F.3d 948, 951, 28 U.S.P.Q.2D (BNA) 1936, 1939 (Fed. Cir. 1993). The prosecution history indicates to a reviewing member of the public that the '272 patent was one of several patents to be issued based upon the same written description disclosure. Parsing the written description, in the context of the prosecution history, puts the reader on notice that the term "spot" has different meanings in the written description depending on its context. Like *Genentech*, therefore, the term must be read to correspond to the only plausible meaning in each context. In light of the prosecution history, the only plausible meaning of the term "spot size", as used in the disputed part of the written description, is the area of discharge on the photoreceptor. The district court therefore erred when it relied upon the frequency of occurrences of the term "spot", in the context which all parties agreed meant the spot of light from the laser beam, to draw a "logical" conclusion that the two disputed occurrences of the term in the written description and all the occurrences of the term in the claims must also have that meaning.

Pitney Bowes, 182 F.3d at 1311; *See also*, *Genentech, Inc. v. The Wellcome Foundation Ltd.*, 29 F.3d 1555, 1564 (Fed. Cir. 1994).

Here, the specification states that frames of video and samples of audio are time encoded and states that these are data blocks (which are depicted in Figures 8a and 8b):

> The converted formatted information of the requested material is then preferably in the form of a series of digital data bytes which represent frames

> of video data and samples of the audio data. A preferred relationship of the audio and video bytes to each other is shown in FIG. 8. Incoming signals are input and converted in sequence, starting with the first and ending with the last frame of the video data, and starting with the first and ending with the last sample of the audio data.
>
> * * *
>
> FIGS. 8a-8e are block diagrams of preferred implementations of data structures and data blocking for items in the audio and video distribution system. FIG. 8a shows the block structure of video data where a video frame 812 is composed of a plurality of video samples 811, and a second of video 813 is composed of a plurality of video frames 812.
>
> FIG. 8b shows the block structure of audio data where an audio data frame 822 is composed of a plurality of audio sample 821, and a second of audio 823 is composed of a plurality of audio data frames 822. FIG. 8c shows the block structure of a data frame 832 composed of a plurality of data bytes 831. The combination of the audio frames 812, video frames 822, and data frames 832 comprise the elements of a single item.[26]

(‘992 patent, 8:7-16 and 19:44-51).

The references to data blocks in the specification relied on by defendants specify other types of data blocks, not those in the phrase “sequence of addressable data blocks:”[27]

- The reference in the ’992 patent at 16:45-52 refers to transferring data from the compressed data library to the communications controller;
- The reference in the ‘992 patent at 18:6-8 refers to the transceiver receiving transmitted data blocks;
- The references in the ‘992 patent at 19:57-60, 19:60-65, and 19:66-20:5 refer to the transmission of the data from the transmission system; and
- The reference in the ‘992 patent at 17:16-18 refers exclusively to satellite transmission and the “sequence of addressable data blocks” in claim 41, which is not limited to satellite transmission.

---

[26] Figures 8d and 8e do not relate to the sequence of addressable data blocks. Figure 8d depicts the items in the source material library. (‘992 patent, 19:51-56). Figure 8e depicts “blocks of an item” when they are being transmitted and shows both multiplexed and non-multiplexed transmission. (‘992 patent, 19:57-20:5).

[27] Interestingly, defendants attempt to mislead the Court by ignoring the portion of the specification which actually discusses the sequence of addressable data blocks and states that the data blocks are the frames of video and the samples of audio. (‘992 patent, 8:7-16 and 19:44-51).

The dictionary definitions cited by the Round 3 defendants are also inapplicable, because they refer to the transmission of data, whereas the phrase "sequence of addressable data blocks" refers to the processing of the data prior to compression.

e) The Court Cannot *Infer* any Meaning to the Phrase "Sequence of Addressable Data Blocks" from the Examiner's Silence in the later-filed '863 Patent Prosecution History

The Round 3 defendants ask the Court to *infer* that the phrase "sequence of addressable data blocks" in claim 41 of the '992 patent does not mean "time encoder" based on the fact that the examiner allowed claim 17 of the later-filed '863 patent. The Round 3 defendants do not cite to any statement by the examiner or to any statement by the patentees in the prosecution history. Instead, they ask the Court to make inferences and speculate regarding the examiner's intent in allowing claim 17 of the '863 patent. The Court cannot construe the phrase "sequence of addressable data blocks" by drawing inferences from an examiner's silence. *Gart*, 254 F.3d at 1342 ("We note that drawing inferences of the meaning of claim terms from an examiner's silence is not a proper basis on which to construe a patent claim."), *citing*, *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1326 (Fed. Cir. 2001).

The Round 3 defendants are speculating that the examiner's silence in allowing claim 17 of the '863 patent has any bearing on the meaning of "sequence of addressable data blocks." For example, the Round 3 defendants contend that persons of skill in the art would have understood that the *Ballantyne* patent taught time encoded video frames. There is no evidence as to what one of ordinary skill in the art would have understood about *Ballantyne*, because *Ballantyne* does not teach, let alone even suggest, the use of time codes. Acacia reserves the right to address these and any other validity arguments at the proper time.

f) "Ordered Data Blocks" Means "Sequence of Addressable Data Blocks"

Claim 19 of the '992 patent uses the phrase "ordered data blocks." The Round 3 defendants contend that "ordered data blocks" is not used in the specification, but it means a "sequence of data blocks," which are not necessarily addressable.

Claim 20 depends from claim 19 and makes clear that "ordered data blocks" are the same as a "sequence of addressable data blocks:"

> *ordering* the converted analog signals and the formatted digital signals into a *sequence of addressable data blocks* and;
>
> compressing the *ordered information*.

('992 patent, claim 20; emphasis added).

g) The Round 3 Defendants' Proposed Construction of the Phrase "Sequence of Addressable Data Blocks" is Improper

The Round 3 defendants contend that their construction for "sequence of addressable data blocks" is proper and that Acacia's objections in its opening brief are unfounded. Although the defendants concede that time encoding is an addressing scheme, their proposed construction does *not* mention time encoding and would not cover time encoding. The Round 3 defendants' proposed construction states that "addressable" means that the storage location for each data block is known. This is not the meaning of "time encoding." Defendants also add the limitation that the "transmission system" must be able to retrieve any individual data block by using its storage location. This limitation appears nowhere in the phrase "sequence of addressable data blocks," or elsewhere in the claims or specification.

The Court should not change its construction for "sequence of addressable data blocks."

30. "Storing, as a File, the Compressed, Formatted, and Sequenced Data With the Assigned Unique Identification Code" ('992 Patent, Claim 41)

The Round 3 defendants contend that the Court has already construed the phrase "storing, as a file, the compressed, formatted, and sequenced data with the assigned unique identification code" to mean that a single file is formed and that the single file contains both the data and the unique identification code. This is not the Court's construction and defendants know this. Otherwise, why would defendants ask the Court to reconsider this term and change its prior construction to state these new limitations?

The Court's construction of this phrase makes clear that it did not construe this phrase as requiring that the unique identification code be stored within the file which contains the data. Had the Court intended to require this limitation, it would have construed this phrase to mean "storing, as a file, the compressed, formatted, and sequenced data ***and*** the unique identification code." It did not. Instead, the Court used the term "accompanying."

In Markman I, the Court explained that it was construing the term "with" consistent with its construction of the term "unique identification code," so that the term "with" means "'accompanying of in the presence of' such that sequenced data blocks are accompanied by a corresponding unique identification code when stored." (Markman I, at 26:3-6). In construing the term "unique identification code," the Court stated that "the unique identification code is assigned by the identification encoding means and accompanies information stored as compressed sequenced data through the data compression process." (Markman I, at 13:22-25). There is no file in the data compression process and therefore the Court could not have meant that the unique identification code is stored within the file.

The Round 3 defendants further contend that the specification "repeatedly and exclusively" discloses that the "compressed, sequenced data and the unique identification code are stored as '**a** file" by citing three parts of the specification which do nothing more than repeat the exact same phrase from the claim. ('863 patent, 2:40-44; 10:17-21; and 19:5-10). These passages do not support defendants' construction. Indeed, when the specification describes the contents of the file, it states that the file may contain the data, time markers, and the program notes, *but* it does not state that the unique identification code is stored within the file. If the patentees intended to require that the file contain both the data and the unique identification code, then this would have been the place to communicate that information, but the patentees did not:

> After compression processing by compressor 116, the compressed audio and video data is preferably formatted and placed into a single file by the compressed data storage means 117. The file may contain the compressed audio and/or video data, time markers, and the program notes. The file is addressable through the unique identification code assigned to the data by the identification encoder 112.

('992 patent, 10:23-30).

Defendants further ignore the language of the claim itself when they argue that the phrase "a file" means that the unique identification code must be stored within the file. The claim does not say "storing, as a file, the compressed, formatted, and sequenced data ***and*** the unique identification code." The claim language is perfectly understandable – the "file" refers only to the compressed,

Hennigan, Bennett & Dorman llp
Lawyers
Los Angeles, California

formatted, and sequenced data. The term "with" means "accompanies," as the Court held, and thus does not require that both the unique identification code and the data be stored in the file.

VIII. CONCLUSION

For the foregoing reasons, Acacia respectfully requests that the Court adopt Acacia's proposed constructions for the terms of claims 14-19 of the '863 patent and claims 4, 7, 8, and 11 of the '720 patent and that the Court let stand its previous constructions for the phrases of the '992 patent for which the Round 3 defendants seek reconsideration.

DATED: August 25, 2006

HENNIGAN BENNETT & DORMAN LLP
Roderick G. Dorman
Alan P. Block
Kevin Shenkman

By ____________________/S/ ______________________
Alan P. Block

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

SERVICE LIST

Juanita R. Brooks Todd G. Miller Fish & Richardson 12390 El Camino Real San Diego, California 92130-2081 ***Counsel for:*** ***ACMP LLC;Ademia Multimedia LLC; Adult Entertainment Broadcast Network; Adult Revenue Services; Audio Communications; CJ Inc.; Club Jenna Inc.; Cyber Trend Inc.; Cybernet Ventures Inc.; Game Link Inc.; Global AVS Inc.; Innovative Ideas International; Lightspeedcash; National A-1 Advertising Inc.; New Destiny Internet Group LLC; VS Media Inc.***	Jonathan E. Singer William R. Woodford Fish & Richardson 60 South Sixth Street, Suite 3300 Minneapolis, Minnesota 55402 ***Counsel for:*** ***ACMP LLC;Ademia Multimedia LLC; Adult Entertainment Broadcast Network; Adult Revenue Services; Audio Communications; CJ Inc.; Club Jenna Inc.; Cyber Trend Inc.; Cybernet Ventures Inc.; Game Link Inc.; Global AVS Inc.; Innovative Ideas International; Lightspeedcash; National A-1 Advertising Inc.; New Destiny Internet Group LLC; VS Media Inc.***
Victor De Gyarfas William J. Robinson Foley & Lardner 2029 Century Park E, 35th Floor Los Angeles, California 90067 ***Counsel for:*** ***International Web Innovations, Inc.***	Gary A. Hecker James Michael Slominski Hecker Law Group 1925 Century Park East, Suite 2300 Los Angeles, California 90067 ***Counsel for:*** ***Offendale Commercial Limited BV***
Mark D. Schneider Gifford, Krass, Groh, Sprinkle, Anderson and Citkowski 280 N. Old Woodward Avenue, Suite 400 Birmingham, Michigan 48009-5394 ***Counsel for:*** ***Askcs.com Inc.***	Alfredo A. Bismonte Daniel H. Fingerman Bobby T. Shih Mount & Stoelker, P.C. River Park Tower, 17th Floor 333 W. San Carlos St. San Jose, CA 95110 ***Counsel for:*** ***Askcs.com Inc.***
Adam Robert Alper David Allen York Latham & Watkins 135 Commonwealth Drive Menlo Park, California 94025 ***Counsel for:*** ***AP Net Marketing Inc.; ICS Inc.***	Rachel Krevans Jason A. Crotty Paul A. Friedman Morrison & Foerster LLP 425 Market Street San Francisco, California 94105-2482 ***Counsel for:*** ***Satellite LLC; Echostar Technologies Corporation; Echostar Communications Corporation***
David C. Doyle Morrison & Foerster LLP 3811 Valley Centre Dr., Suite 500 San Diego, California 92130	

Counsel for: ***Echostar Technologies Corporation***	
Annemarie A. Daley Stephen P. Safranski Robins Kaplan Miller & Ciresi LLP 2800 LaSalle Plaza 800 LaSalle Avenue Minneapolis, Minnesota 55402 ***Counsel for:*** ***Coxcom, Inc.; Hospitality Network, Inc.***	Richard R. Patch J. Timothy Nardell Coblentz, Patch, Duffy & Bass LLP One Ferry Building, Suite 200 San Francisco, California 94111-4213 ***Counsel for:*** ***Coxcom, Inc.; Hospitality Network, Inc.***
Jeffrey H. Dean Kevin D. Hogg Bradford P. Lyerla Carl E. Myers Marshall Gerstein & Borun LLP 6300 Sears Tower 233 South Wacker Drive Chicago, Illinois 60606 ***Counsel for:*** ***Armstrong Group; Arvig Communication Systems; Charter Communications, Inc.; East Cleveland TV and Communications LLC; Massillon Cable TV, Inc.; Wide Open West LLC***	William R. Overend Morgan D. Tovey Reed Smith Crosby Heafey Two Embarcadero Center, Suite 2000 San Francisco, California 94111 ***Counsel for:*** ***Charter Communications, Inc.***
Daralyn J. Durie Joshua H. Lerner David J. Silbert Keker & Van Nest LLP 710 Sansome Street San Francisco, California 94111 ***Counsel for:*** ***Comcast Cable Communications, LLC; Insight Communications, Inc.***	Victor G. Savikas Kevin G. McBride Maria K. Nelson Marsha E. Mullin Jones Day 555 South Flower Street, 50th Floor Los Angeles, California 90071 ***Counsel for:*** ***DirecTV Group, Inc.***
Stephen E. Taylor Jan J. Klohonatz Taylor & Co. Law Offices, Inc. One Ferry Building, Suite 355 San Francisco, California 94111 ***Counsel for:*** ***Mediacom Communications Corporation***	Mitchell D. Lukin Baker Botts L.L.P. One Shell Plaza 910 Louisiana Houston, Texas 77022 ***Counsel for:*** ***Mediacom Communications Corporation; Bresnan Communications***
Jeffrey D. Sullivan Michael J. McNamara Baker Botts L.L.P. 30 Rockefeller Plaza New York, New York 10112 ***Counsel for:*** ***Mediacom Communications Corporation; Bresnan Communications***	Rebecca Anne Bortolotti John Christopher Reich Albert L. Underhill Merchant & Gould 80 S. 8th Street, Suite 3200 Minneapolis, Minnesota 55402 ***Counsel for:*** ***Arvig Communications Systems; Cannon Valley Communications, Inc.; Loretel***

	Cablevision; Mid-Continent Media, Inc.; Savage Communications, Inc.; Sjoberg's Cablevision, Inc.; US Cable Holdings LP
Sean David Garrison Robert Francis Copple Lewis & Roca LLP 40 N. Central Avenue Phoenix, Arizona 85004-4429 ***Counsel for:*** ***Cable America Corp.***	C. Mark Kittredge Perkins Coie Brown & Bain PA P.O. Box 400 Phoenix, Arizona 85001-0400 ***Counsel for:*** ***Cable One Inc.***
Troy Blinn Forderman George Chun Chen Bryan Cave LLP 2 N. Central Avenue, Suite 2200 Phoenix, Arizona 85004-4406 ***Counsel for:*** ***Cable System Service Inc.***	Gregory T. Spalj Fabyanske Westra & Hart PA 800 LaSalle Avenue, Suite 1900 Minneapolis, Minnesota 55402 ***Counsel for:*** ***Cable System Service, Inc.***
Patrick J. Whalen Spencer Fan Britt & Brown LLP 1000 Walnut Street, Suite 1400 Kansas City, Missouri 64106 ***Counsel for:*** ***NPG Cable Inc.***	Fritz Byers 824 Spitzer Bulding 520 Madison Avenue Toledo, Ohio 43604 ***Counsel for:*** ***Block Communications, Inc.***
Clay K. Keller Buckingham, Doolittle & Burroughs 50 South Main Street Akron, Ohio 44308 ***Counsel for:*** ***Nelsonville TV Cable, Inc.***	Melissa G. Ferrario Barry S. Goldsmith Gary H. Nunes Womble Carlyle Sandridge & Rice 8065 Leesburg Pike, Fourth Floor Tysons Corner, VA 22182 ***Counsel for:*** ***Nelsonville TV Cable, Inc.***
Christopher B. Fagan Fay Sharpe Fagan Minnich & McKee 1100 Superior Avenue, Seventh Floor Cleveland, Ohio 44114-2518 ***Counsel for:*** ***Armstrong Group; East Cleveland TV and Communications LLC; Massillon Cable TV, Inc.; Wide Open West, LLC***	Stephen S. Korniczky James V. Fazio Paul Hastings Janofsky & Walker LLP 3579 Valley Centre Drive San Diego, CA 92130 ***Counsel for:*** ***Cebridge Connections***
Benjamin Hershkowitz Goodwin Proctor LLP 599 Lexington Avenue New York, NY 10022 ***Counsel for:*** ***CSC Holdings, Inc.***	David S. Benyacar Daniel Reisner Kaye Scholar LLP 425 Park Avenue New York, NY 10022 ***Counsel for:*** ***Time Warner Cable, Inc.***